

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

FOTOMEDIA TECHNOLOGIES * Civil Docket No.
* 2:07-CV-255
VS. * Marshall, Texas
*
* May 28, 2009
AOL, ET AL * 9:00 A.M.

FOTOMEDIA TECHNOLOGIES * Civil Docket No.
* 2:07-CV-256
VS. * Marshall, Texas
*
* May 28, 2009
ALLTEL COMMUNICATIONS, ET AL * 9:00 A.M.

TRANSCRIPT OF CLAIM CONSTRUCTION HEARING
BEFORE THE HONORABLE JUDGE CHAD EVERINGHAM
UNITED STATES MAGISTRATE JUDGE

APPEARANCES:

FOR THE PLAINTIFFS: (See sign-in sheet.)

FOR THE DEFENDANTS: (See sign-in sheet.)

COURT REPORTER: MS. SUSAN SIMMONS, CSR
Official Court Reporter
100 East Houston, Suite 125
Marshall, TX 75670
903/935-3868

(Proceedings recorded by mechanical stenography,
transcript produced on CAT system.)

P R O C E E D I N G S

COURT SECURITY OFFICER: All rise.

THE COURT: Please be seated.

All right. We have got a consolidated claim construction hearings set today in 2:07-CV-255, Fotomedia Technologies against AOL and others; and 2:07-CV-256, Fotomedia Technologies against Alltel Communications and others.

What says the Plaintiff?

MR. KITCHEN: Good morning, Your Honor. Gary Kitchen, McKool-Smith for the Plaintiff, Fotomedia. I have with me my partner, Robert Manley, John Shumaker from our Austin office and Ivan Wang from our Dallas office, as well as Mr. Eric Tautfest, our co-counsel from the Ware firm, and our client representative Mr. Ryan Fry from Fotomedia.

I believe the rest in the room is related to the Defendants, Your Honor.

And we're ready.

THE COURT: Good morning. For the Defendants?

MR. CHATTERJEE: Good morning, Your Honor, my name is Neel Chatterjee and I represent the Defendant, Photobucket in the earlier filed case. With me from my firm is Gabe Ramsey, who is also from our

1 firm representing Photobucket in this matter.

2 MR. HILL: Good morning, Your Honor.

3 Wesley Hill on behalf of Yahoo, also with Scott
4 Partridge, who will be addressing the Court today on
5 claim construction, Lisa Kelly, and also from Yahoo our
6 client representative, Christiana State.

7 MR. GILLAM: Your Honor, Gil Gillam, on
8 behalf of Photobucket as well.

9 MR. ERSKINE: Your Honor, Blake Erskine and
10 Michael Sacksteder for Shutterfly.

11 MS. DOAN: Your Honor, Jennifer Doan for
12 Alltel Communications, and with me from my firm is Josh
13 Thane and Scott Andrews, and also I have Tom Dunham for
14 Verizon Wireless, Your Honor.

15 MR. DUNHAM: And Sprint as well.

16 MR. BAUER: And Your Honor, Steve Bauer
17 from Proskauer-Rose for T-Mobile and Jennifer Ainsworth
18 in the back, also. We ran out of seats.

19 THE COURT: It's good to see all of y'all.

20 All right. I have set aside an hour and a
21 half per side to address the claim construction
22 disputes. The Plaintiff, you need to use at least half
23 of your time in your opening presentation, otherwise you
24 will be limited to a like amount of time in your
25 rebuttal presentation.

1 MR. KITCHEN: Very well, Your Honor. We
2 intend to reserve 30 minutes.

3 THE COURT: Okay. Well, I will give you a
4 warning when you've -- I'll give you a warning when you
5 have used an hour then.

6 MR. KITCHEN: Thank you, Your Honor.

7 THE COURT: I'll take a recess at 10:25
8 today, so if we're at a breaking point around 10:25,
9 don't be surprised if I have -- it will probably be
10 y'all, if I interrupt you and cut you off. Our court
11 reporter has another engagement. Okay?

12 So, with that, Plaintiff, you may proceed.

13 MR. MANLEY: Good morning, Your Honor,
14 Robert Manley from McKool-Smith on behalf of Fotomedia.

15 THE COURT: Mr. Manley, good morning.

16 MR. MANLEY: Let me get all of my
17 accruments out here and get the stop watch going.

18 Judge, there are -- obviously there are
19 claim terms that are common between the '774 and '936.
20 Mr. Kitchens (sic) and I will divide those, and then Mr.
21 Shumaker will divide the -- will address the terms that
22 are relevant to the other patent.

23 The first term that I would like to address
24 is a server.

25 THE COURT: Tell me how you enabled this

1 distributed system in '96.

2 MR. MANLEY: In '96?

3 THE COURT: Yes.

4 MR. MANLEY: The question that I believe
5 the Court is raising pursuant to the Defendants'
6 argument is is -- No. 1 is this an appropriate time to
7 address enablement? No. 2, can the Court sitting here
8 today decide that it was not enabled and therefore limit
9 the construction of a server to only one server?

10 THE COURT: Can I decide whether or not
11 multiple servers that perform these steps was disclosed
12 in the context of claim construction?

13 MR. MANLEY: I believe you can look to the
14 specification and the claims and see that a server --
15 there is no intent to limit the term a server to only
16 one server, and there is no basis therefore to depart
17 from the claim construction rule that a server means one
18 or more, that's No. 1. And then with respect to the
19 enablement argument, actually, Judge, let me bring to
20 your attention a recent claim construction order that
21 came out of this court, Judge Davis.

22 May I approach?

23 THE COURT: Yes.

24 MR. MANLEY: Where the Defendants raised --
25 here are some copies for you also.

1 MR. CHATTERJEE: Can we have a copy of your
2 slides?

3 MR. MANLEY: Absolutely.

4 Judge, this is the claim construction order
5 that Judge Davis issued, I think in April of this year,
6 April 2009. And the Defendants made the exact same
7 enablement argument at the claim construction stage.
8 Basically it is their opinion is that the -- there was
9 something that was difficult to perform at the time, the
10 patent did not disclose how to do that, and therefore
11 the claims could not be construed to include whatever
12 the defendants decided should be -- should have been
13 enabled.

14 And Judge Davis on page 9 of your opinion
15 there, and I have highlighted it for the Defendants and
16 for the Plaintiffs, turned directly to the heart of the
17 matter in Footnote 11, when entertaining this enablement
18 argument at the claim construction phase. And said,
19 enablement inquiry -- the enablement inquiry implicates
20 claim construction. The Courts first construe the
21 asserted claims before determining whether the
22 specification enables those claims.

23 So Step No. 1 is construction. But more
24 importantly if you will look at -- on the left hand
25 column there on page 8. Defendants enablement arguments

1 are unsupported.

2 Down at the bottom right before Footnote
3 11, the court -- this court stated whether the
4 specification enables the claimed invention is a highly
5 factual inquiry that requires the court to determine:
6 One, the level of skill in the art and the knowledge an
7 ordinary skilled artisan possessed when the inventors
8 filed the application that matured into the patents in
9 suit. Two, the full scope of the claimed invention,
10 which relates back to the full scope after construction.
11 You see it refers back to 11. And three, the level of
12 experimentation that constitutes undue experimentation.
13 Defendants address none of these inquiries.

14 Defendants here address none of those
15 inquiries. So even if the Court asks the questions,
16 gets to the point where it says, what's enabled? The
17 question of whether it was enabled or not or should have
18 been -- actually more importantly, should have been
19 enabled by the patent, the burden is upon the Defendants
20 to come forward with these elements of evidence, and the
21 Defendants have not done that.

22 THE COURT: Okay. Well, my question to you
23 though is -- I understand in general what enablement law
24 requires.

25 MR. MANLEY: Yes, Your Honor.

1 THE COURT: What's your position as to how
2 this distributed system is enabled?

3 MR. MANLEY: I don't think that there is a
4 disclosure in the patent that enables a distributive
5 system. I think the answer is there was no necessity
6 for that. The specification clearly states that -- let
7 me get to the slide and I'll show you the quote. And
8 this is in the summary of the invention, Judge.

9 Actually, Chris, could you take me to Slide
10 8. Slide 8. Maybe I can get there.

11 Summary of the Invention. The present
12 invention is a system and method for processing
13 electronic image data. The system comprises at least
14 one server computer connected to the network.

15 So the summary of the invention clearly
16 anticipates more than one server. If you look beyond
17 the summary of the invention, in the specification to
18 the preferred embodiments, even the preferred
19 embodiments talk about server systems, not a single
20 server. And Defendants in their argument point to this
21 diagram, 31, and say, a-ha, look, a line is draw around
22 all of the functions of 31, and therefore it's got to be
23 in one server or one box. But if you look back to the
24 description, and this is the preferred embodiment -- is
25 merely a preferred embodiment, when the patent talks

1 about what 31 is, it's a server system or server
2 systems. So the patent clearly discloses that the steps
3 can be performed by multiple servers, and the question
4 of whether it needed to disclose how, the answer is no.
5 This is claim construction, that is an issue for another
6 day. And secondly, the elements that the Defendants
7 would have had to have come forward with to win the day
8 on that argument, they simply have not done that in this
9 proceeding.

10 So, the Defendants' attempt to graft on the
11 limitation of one server or limiting it to one server
12 should be rejected, and the general rule that a whatever
13 means one or more should prevail here.

14 The two -- there are two cases that are
15 also addressed in the briefing. One is the Norian
16 Corporation and the Insituform Technologies case. Both
17 of them are instructive into -- as to what the
18 Defendants would have to show in order to limit a server
19 to one and only one server. And as the Federal Circuit
20 taught in the 1996 Insituform Technologies case, the
21 article should be limited to only one if interpreting or
22 construing the claim to mean one or more than one would
23 eliminate an inherent feature of the invention.

24 Again, the Defendants have not shown an
25 inherent feature of the invention that would be

1 eliminated by interpreting the claim consistent with the
2 specification which is one or more servers.

3 THE COURT: Does the patentee use the
4 phrase at least one differently from the word a? Some
5 portions of the claim use the phrase at least one, and
6 the server limitation uses the word a in front of it.
7 Is there a distinction there that I should draw?

8 MR. MANLEY: No, Your Honor. The --

9 THE COURT: Why did he use different terms?

10 MR. MANLEY: The summary of the invention
11 is instructive to this point. The first time that a
12 server is mentioned, the drafter of the patent, the
13 patentee, said at least one server computer in the
14 summary of the invention. And thereafter refers back to
15 the at least one server computer as the server or a
16 server. That is consistent with the way that the claims
17 were written insofar as the first time in the summary of
18 the invention that the server is mentioned, the drafter
19 makes clear it is at least one server. The server or a
20 server relate back to at least one server.

21 And the different terms -- I think the
22 Court's question was the server or a server, were those
23 used differently in the claims, and the answer is yes.
24 But I believe they relate back to the summary of the
25 invention which is at least one server.

1 THE COURT: Well, my question was phrased
2 at least one, is that different from a?

3 MR. MANLEY: No, I don't believe that it
4 is, Your Honor.

5 THE COURT: Okay. And why didn't he use
6 corresponding language in the claims that he used in the
7 specification?

8 I mean, your argument is that they mean the
9 same thing, correct?

10 MR. MANLEY: Yes, Your Honor. The general
11 rule as he knew when he was drafting the claim was that
12 a means one or more, and I believe that's -- you know,
13 I'm obviously not a mind reader, but I believe that
14 would be consistent with why he used the language that
15 he did. There is no clear intent to limit server to one
16 server.

17 The second term that I would like to
18 address, Your Honor, is -- let me get there.

19 THE COURT: Well, if he knew that rule, why
20 did he then switch gears and use at least one in other
21 portions of the claims?

22 MR. MANLEY: Oh, I'm sorry. The other
23 portions of the claims where he said at least one, do
24 not address server. They address other things.

25 THE COURT: I know, but if he knew the rule

1 that a means more than one, then why did he switch gears
2 and use at least one --

3 MR. MANLEY: And use the other? Those
4 other things, I don't believe, appear in the
5 specification with that language, at least one. So, the
6 drafter used that when he needed to make clearer that he
7 was talking about something there needed to be at least
8 one. Server, he had already done that in the summary of
9 the invention. So it was consistent to refer back to
10 that definition in the summary of the invention.

11 The second term that I would like to
12 address, Your Honor, is the receiving the image data
13 embodying an electronic image, the image data
14 transferred under control of the user at the sending
15 computer. I believe the fundamental question here is is
16 this a distributed or divided claim or is it a claim
17 that the drafter focused on what the server did?

18 THE COURT: It's from the servers
19 perception is your argument, right?

20 MR. MANLEY: Yes, Your Honor, it is.

21 THE COURT: It's how the claim language is
22 drafted.

23 MR. MANLEY: Correct, yes, sir.

24 The claim language is directed to what the
25 server does and what the server receives. The server --

1 the preamble of Claim 1 of the '774 is the server
2 executing the steps of, that's clear. Receiving image
3 data, that's clear, that's the server or server system.
4 The image data transferred under the control of the user
5 at the sending computer is what's received by the
6 server. It's not directed to a third party, requiring a
7 third party to send image data.

8 And the reason that we know that the
9 drafter had the choice of either dividing the claim or
10 focusing on what the receiver -- the server did, rather,
11 is the BMC case. I put quite a bit of information about
12 the BMC Vs. Paymentech, Federal Circuit case here. But
13 the important thing that I would like to draw the
14 Court's attention to now is the actual claim language.

15 The Federal Circuit in this case concluded
16 that the claim was distributed or divided. And if you
17 will look at the language indented to the far right,
18 prompting the caller to enter a payment number, that's
19 what a server does. Prompting the caller to enter a
20 payment amount, again done by the server. Accessing a
21 remote payment network associated with the entered
22 payment number, again the server does that. But the
23 fourth element here is clear that the server does not do
24 that, the next step. The accessed remote payment
25 network determining, during the session, whether

1 sufficient available credit or funds exist. That is a
2 divided claim.

3 The rationale of the Federal Circuit, I
4 think, is particularly instructive here and leads
5 inextricably to the conclusion that the receiving the
6 image data is not a distributed claim.

7 The Court said, the concerns over a party
8 avoiding infringement by arms-length cooperation can
9 usually be offset by proper claim drafting. A patentee
10 can usually structure a claim to capture infringement by
11 a single party. And the Federal Circuit referenced this
12 article by Mark Lemley, Divided Infringement Claims, as
13 its support. It went on to say in this case, for
14 example, BMC could have drafted its claims to focus on
15 one entity. The steps of the claims might have featured
16 references to a single party's supplying or receiving
17 each element of the claimed process.

18 I looked at this article that the Federal
19 Circuit cited in support, and it is very instructive.
20 This article -- this is a quote directly out of the
21 article and what it says, obviously, is most inventions
22 that involve cooperation of multiple entities can be
23 covered using claims drafted in a unitary form simply by
24 focusing on one entity and whether it supplies or
25 receives any given element. Compare, for example, two

1 different claims directed roughly to a method commonly
2 employed in electronic commerce...

3 So, here the author juxtaposed a divided
4 claim covering the same invention as a non-divided
5 claim. And you will see under the first claim the
6 patent drafter stated, transmitting a request to a
7 server. That's a third-party act, transmitting the
8 request to the server. In response to the request,
9 supplying from the server a server certificate, that's
10 what the server does, and then (c), generating at the
11 client a unique client key and communicating the unique
12 client key to the server, and that's again at the client
13 computer. And then (d), thereafter communicating
14 information, blah, blah, blah, the server does that.
15 So, the client does (a) and (c), the server does (b) and
16 (d). That's divided.

17 A claim drafted to capture what the server
18 and what only the server does is an example of No. 2.
19 So instead of transmitting requests to the server,
20 receiving a request from a client, (b) is the same. And
21 then (c), which is very similar to the claim in this
22 case, receiving from the client a unique client key
23 communicated using the server's public key.

24 The article concludes by stating that both
25 claims seek to cover the same invention, but the first

1 is distributed and the second is not because the first
2 requires that steps be performed by both the client and
3 the server, while the second, only the server is
4 performing any steps.

5 So it is clear that in this case the
6 receiving image data is what the server does, and then
7 the definition of what the image data is that's the
8 language onto which the Defendants are attempting to
9 graft the sending limitation.

10 The next argument that the Defendants make
11 is that as part of the bargaining with the patent
12 office, the patentees traded away the receiving part of
13 the claim and introduced the requirement that a third
14 party send the image data, which is simply not the case.
15 The Defendants stopped short of the part that I would
16 like to focus the Court on when they were quoting the
17 prosecution history in their brief. It's lengthy, and I
18 apologize for that, but I put the whole thing in here so
19 the Court would have the entire context.

20 At the beginning of the prosecution excerpt
21 there, Wright teaches sending an identifier representing
22 the greeting card image to the server, to the central
23 server. That the Wright was a prior art that the
24 patentees were distinguishing.

25 And then if you go down to the bottom of

1 that paragraph, the system of Wright teaches selecting a
2 greeting card image stored on a central image server,
3 prior art. The present invention is directed to a
4 system where an image data is created by the sender and
5 not selected from preexisting -- from a preexisting list
6 of greeting card images. Now, here is the part the
7 Defendants didn't quote. Claim 1 and 2 have been
8 amended to clarify the point wherein the server receives
9 image data embodying the electronic image rather than
10 simply receiving image data that simply identifies a
11 preexisting image on a stored server.

12 The amendment was made to clarify that the
13 receiver -- that the type of image data that the
14 receiver -- that the server receives, and that is the
15 actual picture itself.

16 So, in short the receiving step should not
17 have grafted on to it or be redrafted through claim
18 construction to require a distribution between parties.
19 The drafters knew what they were doing and they focused
20 on the receiver, what it did, and what it received.

21 The next term I would like to address, Your
22 Honor, is storing, stored (sic) the received image data,
23 stored, stored image data.

24 Fotomedia's position is that no further
25 construction is required or copied or moved to a storage

1 medium. And the Defendants would like to introduce the
2 limitation that the information be stored into a
3 database.

4 Well, looking at the claims themselves
5 there is no support in the claims for limiting each
6 instance of storage or storage -- stored data, or
7 storage device rather to a database. In fact, the
8 claims -- 1 of the '774 and 1 and 2 of the '936 simply
9 say storing device or stored. There is no limitation
10 that the data or information be stored in a database.
11 Claim 17, however, specifically addresses and does have
12 that limitation.

13 Looking at the -- on to the specification,
14 in the summary of the invention, storing again is not so
15 limited in a database. It simply says storing.

16 And then even if you look beyond the
17 summary of the invention to the preferred embodiments,
18 the preferred embodiments show that when the patent uses
19 the term database, it uses it in a way that means
20 something no more than temporary storage. For example,
21 in the '774, Column 4, line 67 through Column 5, line 6,
22 the patent states -- and I'm reading the underlined
23 language, Your Honor -- the temporary storage is called
24 the session database, 62. So we see there that even in
25 the preferred embodiments, database refers only to

1 temporary storage, not necessarily a database or a
2 particular organization of data in storage.

3 Another example where the patent is
4 discussing the preferred embodiment, '774, Column 5,
5 lines 19-23. Graphical data, graphical (sic) images and
6 photographs are stored in a file system of the server in
7 a directory specifically created to store the temporary
8 image files, herein designated as a temp image database.

9 So, here are two examples where the
10 preferred embodiments used the term database, but it is
11 clear from the language that is nothing more than in the
12 first instance temporary storage or a file -- the file
13 system on the server in a directory specifically created
14 to store the temporary image files.

15 The last term that I would like to address
16 and then I will turn it over to my colleague, Mr.
17 Kitchen, is generate, display or generate a display, and
18 I will be brief here.

19 Generate, Fotomedia proposes simply the
20 plain and ordinary construction or create. The
21 Defendants' claim construction imposes the additional
22 limitation of make a visual representation. To begin
23 with, create is a verb, what is create is the object.
24 The Defendants have, with their proposed construction,
25 attempted to limit the verb generate to an object visual

1 representation of, and there's no support in the claims
2 and there is no support in the specification. To the
3 contrary actually, the claims specify that other things
4 are generated. Generating a message including an
5 identifier, generate a display including at least a
6 portion of the processed electronic image data.

7 Similarly the specification discloses that
8 things other than a visual representation are generated,
9 and there are six examples on Slide 33.

10 And the last point that I would make would
11 be this additional limitation that the Defendants seek
12 to impose which would be fixed, fixed image. The
13 concept of fixed or the term fixed appears no where in
14 the claims. Where it is used in the patent, it is used
15 in the '774, Column 6, lines 26-29 to address ways to
16 improve the efficiency of the system. And there is the
17 quote, the use of static or generated images improves
18 the efficiency of the system by preventing the
19 recreation and transmission of images that are
20 essentially fixed during the operation of the system.

21 So Defendants attempt to limit display,
22 generate a display, to a fixed image should be rejected.

23 And one last point, Chris, if you could
24 bring up the '936 Claim 1, Column 14, 59-60.

25 A display is not necessarily limited to an

1 image. The claim language itself evidences generate a
2 display including at least a portion of the processed
3 electronic image data.

4 THE COURT: Well, do you dispute that the
5 display has to be something visual?

6 MR. MANLEY: It has to be viewable. In the
7 Defendants' brief they argue that it is visible -- that
8 it is, I believe, it's visible. Matter of fact --

9 THE COURT: Well, the word is display.

10 MR. MANLEY: Display is -- let me get that
11 -- it's data that may be viewed. And if by -- in their
12 brief on page 18 and 19, they argue that a display must
13 be visible, something visible, something that can be
14 seen, which on its face is just incorrect. The data is
15 not seen until it is retrieved at the recipient
16 computer. So, the display is something that is not
17 visible 24/7. It is data that may be viewed and is
18 viewed when retrieved by the recipient computer. But if
19 in arguing for these -- for their construction, the
20 Defendants are attempting to impose a limitation that
21 requires that something is visible, irrespective of
22 whether its been retrieved or not, that's simply
23 improper.

24 Chris, if you could go to Slide 35.

25 The reason as '936, Claim 1 made clear that

1 the display is available for viewing, it's not
2 necessarily visible at that time. It is data that can
3 be viewed, it is not visible.

4 Thank you, Your Honor, I'll pass it to my
5 colleague, Mr. Kitchen.

6 THE COURT: Okay. Thank you, Mr. Manley.

7 MR. KITCHEN: Good morning again, Your
8 Honor.

9 The next term we would like to deal with is
10 really a set of terms that have been briefed elsewhere
11 individually, associate a uniform resource locator with
12 a display. Our contention is that no further
13 construction of that phrase is necessary.

14 Associate is dealt with as an individual
15 term. The dispute there, both the Plaintiff and the
16 Defendant agree that associate means relate to. The
17 degree of the relationship, whether it should be
18 specific and unique is at issue, and I'll deal with that
19 when I deal with the identifier term because it's the
20 same basic argument.

21 And the term display, as Mr. Manley points
22 out, is subject to dispute and the Court will construe
23 that term. Defendants attempt to string this together
24 in an effort to impose an order of steps, and the
25 Court's obviously very familiar with the argumentation,

1 and so I won't bore you with those issues.

2 But essentially in the analysis, for
3 example, in the Altiris case, when you begin looking at
4 this issue, you will look at whether the claims
5 themselves require such an order, whether the claims
6 prohibit an association of a URL, and whether in an
7 exemplary embodiment the specification suggests that
8 it can be done in a different order.

9 Now, in this particular claim -- and I will
10 deal with it more specifically later -- I'd just like to
11 draw the Court's attention to the fact that, one, this
12 associate term is just relating to. In other words,
13 there is no indication anywhere in those two steps that
14 associating a uniform resource locator actually performs
15 any sort of operation upon the display.

16 Defendants latch on to the fact that a
17 display is generated in the previous step, and that a
18 URL is associated with a display. And I'm going to go
19 through Your Honor's previous opinions with regard to
20 apparatus claims that have specific order, but that I
21 think -- I think the primary distinction will be
22 between those cases and this one that there is no
23 operation performed by the association step, it's merely
24 a relationship. It's merely linking the URL to that
25 specific display, and that could be done when the

1 information is input from the user, that could be done
2 when the information is stored, that could be done when
3 the processing of the electronic image is done. There
4 is no requirement, in other words, in the claim language
5 itself that the URL be associated after a display is
6 generated.

7 Defendants rely --

8 THE COURT: Does the specification include
9 an example of associating a URL with a non-existent
10 display? Such as for example, when you key in the
11 information.

12 MR. KITCHEN: I believe it does, Your
13 Honor, to this extent, and I won't suggest to you that
14 it specifically says associating a URL, but the
15 specification does indicate circumstances, for example,
16 when the user first comes to the site, the initial web
17 page is a blank electronic postcard. Essentially that
18 is a blank data structure, and at that point there is
19 nothing in the specification that indicates a URL could
20 not be related to that blank data structure.

21 THE COURT: Well, am I trying to figure out
22 what the patentee invented or what he didn't invent?

23 MR. KITCHEN: Well, I would only suggest to
24 you, Your Honor, that the relationship between the
25 preferred embodiment, the Defendants rely on, that is

1 the card key and the specific URL representation is too
2 limiting. And what I'm, I guess, suggesting to the
3 Court is that there are situations described in the
4 specification where a URL may be associated. Further,
5 the specification talks about regenerating the postcard,
6 and in that situation, if you think about it, when the
7 information, the session database changes, the server
8 regenerates the postcard and the new information appears
9 on the postcard. This process can also be used to
10 change a field that has already been entered. The card
11 is always displayed with all of the latest information
12 in the correct locations.

13 If it were the case that the URL had to be
14 assigned after the display was generated, then there
15 would have to be some reference in the specification to
16 associating a different URL. And there is no
17 indication, no indication, that a different URL is
18 assigned when the display is regenerated.

19 I'm not sure that answers the Court's
20 question directly, but I think the point of the law is
21 with regard to this that unless there must an order to
22 the steps and the specification dictates that order or
23 the claims dictate that order, then it's not appropriate
24 to apply one.

25 And if I could just back up with the

1 Court's indulgence, and I know that this distinction is
2 one the Court has in some circumstances agreed with and
3 in others not agreed with, in Combined Systems which is
4 the case that the Defendants cite, they are dealing with
5 a method claim and this is obviously an apparatus claim.
6 And while the Court has and the Federal Circuit has --

7 THE COURT: It's a software system though,
8 right?

9 MR. KITCHEN: Pardon me?

10 THE COURT: It's a software implementation
11 though, right?

12 MR. KITCHEN: Correct. Has, in fact, said
13 that there are circumstances where it's appropriate to
14 apply an order in an apparatus claim, it must take --
15 the specific language is that it must take place in a --
16 the steps or processes that must take place in a
17 particular order. And I don't believe that's the case
18 here in this apparatus claim. And as the Court
19 rightfully pointed out as recently as two weeks ago in
20 Versata Vs. SAP, there is a two-part test that deals
21 with that issue. We look to the claim language first,
22 and then we look to the rest of the specification.

23 THE COURT: Well, the record will reflect
24 that you've characterized that opinion as rightfully
25 recognizing something.

1 (Laughter.)

2 THE COURT: I'm being facetious, Mr.
3 Kitchen.

4 MR. KITCHEN: I appreciate that, Your
5 Honor.

6 Rightfully recognized the test, not
7 necessarily the application of it. Although I dare not
8 question that at this point.

9 And I think two other things are important
10 --

11 THE COURT: You can question it, I'm just
12 not sure this is the appropriate forum for doing it.

13 MR. KITCHEN: I agree with you, Your Honor.

14 The notion that the or said, and that is
15 really what the Defendants are arguing here is that the
16 display relates back to the previous step, and that in
17 and of itself creates the ordering, has been rejected by
18 Respironics, and that was, of course, based on
19 Interactive Gift, and Interactive Gift, I think, is
20 going to be the determinative case here. It says there
21 is no reason why step one is providing of information to
22 the IMM must occur before step four is receiving the
23 request reproduction code. In other words, I believe,
24 the law says that it's not required that we provide
25 entire specification support. But they've got to

1 provide evidence and argumentation that suggests it must
2 be done.

3 Now, in the Court's Versata/SAP opinion,
4 for example, where the Court used that analysis on an
5 apparatus claim, I think that the claims were distinctly
6 different. If you look at what was done, for example,
7 in Oak Tech, which is the Federal Circuit case the Court
8 cited to in Versata, you've got specific error
9 corrections circuitry and there are interactions between
10 that circuitry. The error correction circuitry must
11 perform error correction. The cyclic redundancy checker
12 must detect errors, it must ultimately provide corrected
13 data. These required interactions support the
14 Commission's observation, the court says.

15 Furthermore, when they look at the claim
16 language regarding assembled data. It's processed by
17 the error correction circuitry and converted into
18 corrected assembled data. That second step is acting
19 upon the output from the previous step and manipulating
20 it in some fashion. Comparing it, storing it,
21 processing it, et cetera.

22 The same is true in the other case that the
23 Court cited in Versata, Visto Vs. Good. And the Court,
24 I'm sure, will recall that the -- Claim 22 of the '192
25 patent required generating first examination results,

1 generating second examination results. The Court
2 ultimately ordered it as initiating steps (a) and (b)
3 first from within the firewall and then generating a
4 preferred version from the first workspace element from
5 the copy based on the first and second examination
6 results, which involved a comparison of those two
7 results.

8 The distinguishing factor in this case --
9 well, let me just clear Versata first, if you don't
10 mind. In Versata you had a situation where you had to
11 retrieve data because you were going to perform an
12 operation on it, and that was to sort it.

13 In the instant case all we're doing is
14 associating, relating a URL. We're just making a
15 linkage. The uniform resource locator does not make any
16 comparisons, it does not process in any way, it doesn't
17 impose any manipulation whatsoever on that previous
18 step. And I think that distinguishes these claims from
19 the claims in Oak Tech, Visto and Versata. In this
20 particular situation, since there is no processing going
21 on of the previous display in the next step, there is no
22 justification, there is no must-read as the law
23 requires.

24 I think the claim relationship is more akin
25 to Interactive Gift. And the Court may recall that in

1 Interactive Gift in the Freeny patent, each information
2 -- in the first step it required that each information
3 being uniquely identified by a catalog code. And in the
4 last step, reproducing in a material object the
5 information identified by the catalog code. And the
6 defendants argued in Interactive Gift that step one had
7 to occur before step four, but the court said, no,
8 that's not the case. And this is a very similar
9 situation, we're just creating an identification with a
10 URL. We're just relating the URL. And there's no
11 reason why that can't be done at another step in the
12 claim because there is no operation performed by that
13 step.

14 Now, the Defendant seeks to impart the idea
15 that this URL must be included because the URL cannot be
16 created before the display is generated because the URL
17 includes a card key that is created after the user is
18 finished composing the display and clicks send.

19 A, that's clearly importation of a
20 preferred embodiment, just the postcard. There are
21 variations in the patent of various manipulations that
22 can be done which would take us out of this context.
23 So, it's inappropriate to import this limitation on the
24 specific claim. The idea that a card key is created is
25 specifically the preferred embodiment.

1 And secondly, the card key in and of itself
2 is just a portion of the URL. It's just the last
3 portion of the URL that directs the URL to that html
4 page that has one or more displays on it.

5 And so, in this particular context it's not
6 sufficient for the Defendant to take a limitation of the
7 preferred embodiment and say, the steps must occur in
8 this particular order.

9 And as I pointed out to the Court, there is
10 other places in the specification where that association
11 could take place. And it's not necessary that the
12 inventor provide every potential embodiment in its
13 description of the invention. And this regeneration
14 effect, I believe, as well creates a situation where by
15 necessity the URL may have already been assigned and the
16 user is customizing by going back to that URL and
17 essentially regenerating the postcard, and the new
18 information appears on the postcard --

19 THE COURT: Would the new postcard have a
20 different card key associated with it?

21 MR. KITCHEN: I don't believe so, Your
22 Honor.

23 THE COURT: Okay.

24 MR. KITCHEN: It would have the same URL.
25 I believe all the card key is is the last portion beyond

1 the last forward slash of the URL.

2 Any other questions, Your Honor?

3 THE COURT: No.

4 MR. KITCHEN: Okay. The next term is the
5 digital image.

6 And I need Mr. Manley's stop watch here --

7 MR. MANLEY: It's right there on the --

8 MR. KITCHEN: Ahh, thank you.

9 The dispute here, digital image and image
10 data, without the definitive article the, are agreed
11 terms. The parties have agreed they have their plain
12 and ordinary meaning. The issue is whether or not when
13 that definitive article the is imposed, does it change
14 the meaning of the term? And just for the Court's
15 reference, in 4-5(d), the Defendants presented two
16 different definitions. One for the digital image, one
17 for image data. They are not significantly different,
18 and in their final briefing where it says new there,
19 they use one definition for both. And so, my arguments
20 are addressed to that, I don't think it makes any real
21 difference, but for the Court's reference, the
22 Defendants' briefing indicates -- and I believe that's
23 the live pleading, the uploaded unprocessed image data.

24 And essentially what the Defendants are
25 trying to do is import two terms, uploaded and

1 unprocessed. Now, in the preferred embodiment the
2 intrinsic references include image data that is clearly,
3 clearly not uploaded. For example, at Column 10 -- in
4 the '936 at Column 10, line 67 through Column 11, line
5 2, it states: In the photo file operation 351, the user
6 specifies a file on the local client computer that holds
7 the image data he or she wants to use on their card.
8 That is a file that is not uploaded, that's still in the
9 client computer. So there is support in the
10 specification for the idea of data that is both uploaded
11 and not uploaded.

12 The plain language of the claims indicates
13 that the digital image existed prior to the uploading.
14 Now the '936 states: Allowing a user of the client
15 computer to upload to the server a digital image,
16 contact information, and an e-mail address of a
17 recipient implies, implies that there is image
18 information that is not yet uploaded because the client
19 -- the user is allowed to use the client computer to
20 make the upload. And that's at Column 15, lines 28-31.

21 Later references to the digital image refer
22 back to that same initially recited digital image, and
23 therefore cannot be limited to image data that is
24 uploaded only. For example, there is a reference to
25 storing by the server, the digital image and the content

1 information. That is clearly information that is
2 uploaded in certain circumstances and in the previous
3 statement, information that comes from the client
4 computer, comes from the user and is uploaded. So, the
5 digital image -- the digital image itself remains the
6 same, but it is in a different state when it is
7 uploaded, and it's also in a different state when it is
8 processed.

9 And there is justification of the law for
10 having that differentiation between the definitions of
11 the claim. Under Paragon, for example, Paragon
12 Solutions Vs. Timex, 2009 U.S. Lexis 10884, the Federal
13 Circuit has stated: We apply a presumption that the
14 same terms appearing in different portions of the claims
15 should be given the same meaning. And that is the
16 citation the Defendants use in their briefing. But this
17 latter portion says something different: Unless it is
18 clear from the spec and the prosecution history that the
19 terms have different meanings at different portions of
20 the claim.

21 And our contention is that a digital image,
22 when it's uploaded, has a bit of a different meaning
23 than it does when it's not uploaded. And it can have
24 those two different meanings.

25 Similarly with regard to processing. That

1 particular term was defined in the patent by the
2 inventor in '936 at Column 3, lines 4-11. Most
3 importantly I will direct the Court's attention to the
4 terms formatting and storing are included within the
5 idea of processing.

6 Now, Defendants want to limit this term
7 image data to only unprocessed image data, but nothing
8 in the spec or in the claims forbids any processing or
9 requires any processing. In point of fact, the
10 preferred embodiments are replete with examples of both.

11 For example, Column 11, lines 28-30 of the
12 '936, when a photograph is received on the server, the
13 electronic postcard server software processes the photo
14 using several steps as illustrated in Figure 3a.

15 Well, in the first place, this implies that
16 the photograph was at one point not uploaded. Once it
17 is uploaded, then it can be processed. And this
18 indicates that the Defendants' idea that the digital
19 image must be unprocessed is inappropriate and
20 inconsistent with the specification and reads in an
21 inappropriate limitation.

22 Similarly at Column 11, 31-38, the image
23 data that is posted to the server must be in a size and
24 format that the electronic postcard software can handle.
25 The first step is to check the byte count of the data,

1 et cetera. Next the image data is saved as a temporary
2 file and the type of the file is checked. Again, the
3 image data is processed according to the inventor's own
4 definition, which is to store, which includes to store.
5 And that specific reference to check the image next, the
6 image data is saved falls within that definition of
7 processes. So, this is a usage of that particular
8 language within a specification that indicates it is
9 processed, not unprocessed as the Defendants would have
10 one believe. Again, and checking the byte count of the
11 data refers to formatting and that is also part of the
12 definition of process that the inventor included.

13 THE COURT: Mr. Kitchen, let me ask you
14 about Claim 1 of the '936 patent.

15 MR. KITCHEN: Yes, Your Honor.

16 THE COURT: One of the claim limitations
17 includes the language the CPU adapted by a program to
18 store the user information in the storage device, and
19 then next limitation is process the electronic image
20 data.

21 User information, as I understand it,
22 includes both the electronic image data or at a minimum
23 the electronic image data and at least one e-mail
24 address of a recipient.

25 MR. KITCHEN: I believe that is correct,

1 Your Honor.

2 THE COURT: If you have stored the user
3 information as required by that next limitation there --

4 MR. KITCHEN: Correct.

5 THE COURT: -- in the storage device, is
6 your argument that you have at that point satisfied the
7 next limitation, processed the electronic image data?

8 MR. KITCHEN: No, Your Honor, it is not.
9 And I'm not sure I'm certain where Your Honor is driving
10 here, but --

11 THE COURT: Well, if your definition of
12 process includes storing?

13 MR. KITCHEN: Well, that may not be the
14 only process that is applied to the image data, there
15 may be other processes that are included.

16 THE COURT: In a situation where there is
17 no other processing that is done, is it your position
18 that by storing the user information in the storage
19 device that the CPU has then processed the electronic
20 image data?

21 MR. KITCHEN: That would seem to fit within
22 the definition that the inventor has included within the
23 patent, sir, yes.

24 THE COURT: Okay. I understand your
25 position. So your view then is that -- I understand

1 what the specification says is meant by processing.

2 MR. KITCHEN: Yes, sir.

3 THE COURT: But then in that instance
4 storing and processing would just be redundant in the
5 claim?

6 MR. KITCHEN: Well, it says store the user
7 information, but it might not include all of the
8 electronic image data. In other words, the step reads
9 store the user information in the storage device, user
10 information would include electronic image data and at
11 least one e-mail address. It doesn't say it would
12 include all electronic image data. So, it is possible
13 that, in fact, I guess the reference back to the
14 electronic image data might be interpreted that way, but
15 I don't believe it satisfies that next step.

16 THE COURT: Okay.

17 MR. KITCHEN: I will have to give that some
18 thought, Your Honor, as well.

19 Finally, identifier, information for
20 identifying image data. The only issue here is whether
21 it's uniquely identifying particular image data, and the
22 issue is whether or not the identifier must uniquely
23 identify image data.

24 And in the Defendants' briefing it is not
25 entirely clear to me whether their position is that it

1 must be a single image. It appears from their
2 definition that it might not be, however when one reads
3 the briefing closely, one finds that this notion of
4 identifier -- and I'm quoting from page 13 of the brief
5 -- the identifier exists to serve only one purpose, to
6 identify a particular image and thereby enable access to
7 that specific image. If the identifier did not uniquely
8 identify a particular image, it would not be able to
9 perform its stated purpose, only the Defendants'
10 construction correctly aligns the identifier with this
11 purpose.

12 And it is simply not the case that the spec
13 provides that the identifier be associated with a single
14 image. In several places the specification supports the
15 idea that one or more displays may be assigned to a
16 unique identifier. The person receiving the unique
17 identifier can retrieve the one or more displays
18 represented by the identifier from the server for
19 viewing.

20 Furthermore in this second sentence here in
21 Column 5, as an alternate embodiment, the temporary
22 graphical data files may be retained for additional
23 usage such as creation of an album of images. And so
24 there is a multiplicity of purposes of displays or
25 images associated with a given identifier in the

1 specification. And they are simply trying to read it
2 out, and the way they are trying to read it out, I think
3 and I've put this definition up here just so that's it's
4 easier to explain, is they have taken this term unique
5 and essentially used one part of -- one possible
6 definition of the term unique and implied it, and that
7 is being the sole or only. They are trying to suggest
8 that because it says a unique identifier that it is only
9 related to one specific image. That is not the case.

10 The word unique in this context means being
11 without a like, more like discreet. It is one
12 identifier for a set of displays or a set of images,
13 another identifier for another set of displays or
14 images.

15 And I don't think that there is any
16 justification for that in the construction for
17 restricting it to an image in the construction.

18 THE COURT: Does there have to be some type
19 of relationship between the sets of images that are
20 identified under your definition of unique?

21 MR. KITCHEN: The sets of images would be
22 tied to one identifier, yes, Your Honor.

23 THE COURT: Well, but some other
24 relationship beyond that? An album, that type of --

25 MR. KITCHEN: It could be an album, and

1 there is variance, but it doesn't necessarily have to be
2 those. It could just be a set of images or set of
3 displays that a particular user has decided to associate
4 with a particular URL, and when he provides that to the
5 recipient, the recipient gets the URL, clicks on it and
6 gets this variety of images or displays.

7 Does that answer your question?

8 THE COURT: Yes.

9 MR. KITCHEN: Now one thing I should say is
10 Defendant appears to rely again on this card key
11 analysis, and I promised that I would go back to this
12 idea of association. The same analysis applies to the
13 Defendants' definition of associate when they are
14 attempting to create a unique and specific association.
15 There is just nothing in the specification that supports
16 that, and the same parts of the specification that I
17 have cited to you indicating that the identifier can be
18 associated with one or more displays certainly supports
19 our construction that it is related to one or more
20 displays.

21 Again, they cite back to this idea of a
22 card key that uniquely specifies that particular
23 electronic postcard, that is clearly a preferred
24 embodiment, and not the only invention that is described
25 in the '936. And to read that card key analysis in

1 reference to a particular electronic postcard into the
2 entire claims would be to import a limitation
3 inappropriately.

4 If the Court has nothing further, I will
5 turn it over to Mr. Shumaker.

6 MR. MANLEY: I just want to -- John, can I
7 have a minute of your time?

8 Judge, may I?

9 I have been sitting here reflecting on our
10 conversation about the server term and the enablement,
11 and I don't think I responded to your question the way I
12 intended to, and so I would like to straighten it out.

13 I believe you asked me whether the
14 distributive system of servers were enabled. The answer
15 to that question is yes, they are by the patent. What I
16 intended to convey to the Court by my earlier answer and
17 conversation about the enablement requirement is that I
18 don't believe the patent goes into pages and pages of
19 how servers would work in tandem, nor do I think that
20 was -- is required in order to enable multiple servers
21 or a distributive system because it would not require
22 undue experimentation by an artisan skilled in the art
23 to implement multiple servers or a server system as set
24 forth in the specification or a distributive system.

25 That's what I intended to say, and I wanted

1 to make sure I got that clear on the record.

2 Thank you, Your Honor.

3 MR. SHUMAKER: Good morning, Your Honor.

4 First I would like to address one more term
5 from the previous patent we've been discussing, and
6 that's the term computer-related terms.

7 There is one issue associated with various
8 terms and that's, should a computer be construed as a
9 personal computer or not. Fotomedia says no; Defendants
10 say yes.

11 One argument that I want to point out that
12 I think is telling. If you look at the preferred
13 embodiment of the invention, the preferred embodiment is
14 not limited to a personal computer. The preferred
15 embodiment discusses a personal computer, but it also
16 identifies any other computer capable of running a
17 standard web browser. So not only did the Defendants
18 import a limitation from the preferred embodiment in its
19 -- this construction, their construction is actually
20 more narrow than a preferred embodiment and simply must
21 be rejected.

22 Furthermore, there is no support in the
23 claim language or the prosecution -- claim language or
24 the specification for Defendants' construction of
25 personal computer.

1 Now I want to jump to the '231 patent. The
2 first term I want to discuss is roles. What is the
3 construction of a role? Before --

4 THE COURT: Why shouldn't I adopt the
5 definition that is provided in the article that both
6 sides seem to agree is written by someone who knows what
7 he's talking about in this article?

8 MR. SHUMAKER: I think that's a very good
9 starting point for the construction. A couple of
10 issues. One, the critical issue is that for a role to
11 exist, a role need not be assigned to a user. A role is
12 simply a designation to which access privileges can be
13 assigned and also to which users can be assigned. So,
14 if it's clear that a role is not necessarily assigned to
15 a user or even an access privilege, yes, then I think
16 Fotomedia would be agreeable to the construction.

17 The disagreement Fotomedia has with the
18 Defendants' current construction is that its use of the
19 term intermediary designation. Fotomedia would be fine
20 with either intermediary or designation, but the phrase
21 intermediary designation itself is vague and ambiguous.
22 It's just simply unclear what that term means.

23 Let me jump to the next term, associating
24 users who access the images with the roles.

25 There are a couple of issues that Fotomedia

1 has with this term. First and foremost is that
2 assigning a list to a user is not disclosed in the
3 specification. There is clearly no intrinsic evidence
4 for assigning a list of users to roles. That part of
5 the Defendants' construction is clearly improper.

6 The other aspects of this term is
7 essentially the term needs no construction, no further
8 construction. The term is associating users who will
9 access the image with the roles.

10 What does the claim language say? If you
11 at look at it, essentially you are associating users who
12 access the images with roles. So, Fotomedia's position
13 is that that phrase requires no further construction
14 beyond the definition or construction of roles.

15 The Defendants, on the other hand, want to
16 impose not only the limitation of assigning a list of
17 users, which is clearly unsupported in the
18 specification, but also the limitation for at least two
19 roles, which again, is unsupported. I mean, it is part
20 of the specification, but it is importing limitations
21 from the specification into the claim language.

22 THE COURT: Why didn't the patentee draft
23 the claim language -- if you can go back to that slide.

24 (Complies.)

25 MR. SHUMAKER: This slide?

1 THE COURT: Yes. Why wouldn't he have
2 drafted the claim language with associating a user who
3 will access the image with a role?

4 MR. SHUMAKER: As opposed to associating
5 users?

6 THE COURT: The pleural of both.

7 MR. SHUMAKER: Sure. Mainly to enable --
8 allow for the possibility that there is going to be more
9 than one user that accesses a system. It makes no sense
10 to have a single user or a single owner.

11 THE COURT: Well, if a means one or more.

12 MR. SHUMAKER: Yes.

13 THE COURT: If the patentee knew that rule,
14 why wouldn't this patentee also have known that rule?

15 MR. SHUMAKER: They certainly could have
16 drafted it as associating a user who will access the
17 image with a role, absolutely. I see no problem with
18 that, but the question is, well, why didn't they do
19 that? I think if you look at the phrase associating
20 users who will access the image with the roles, the
21 question is, well, the term users, when it's plural,
22 does that necessarily mean there has to be at least two
23 users? I think the answer to that answer (sic) is yes,
24 there has to be at least two users, that's probably why
25 there was an "s" associated with it.

1 Now, the question is when you associate
2 users with roles, are you associating the same role to
3 those two users or are you associating different roles
4 to those two users? So, when you start incorporating
5 associating users who will access the image with a role,
6 does that imply that that same role is associated to the
7 users or not? I think that would be ambiguous. Now, if
8 you leave it in the possessive form, roles, the role
9 could be -- the roles possessive could incorporate
10 either the same role associated to two users, so you
11 have in total two roles, but it's the same role, or it
12 could be two different roles. I think this language
13 allows a possibility that a separate -- a single role
14 could be associated with two users or two different
15 roles could be associated with two users. The critical
16 issue is are there -- is there more than one role and is
17 there more one user in the system.

18 But I grant you, is the language perfect?
19 By no means, it's not perfect. That's why we're here.

20 Another issue with the Defendants'
21 construction, one, they are trying to equate assigning
22 with associating. The claim language uses associating,
23 not assigning. Furthermore, Claim 2 of the '231 patent
24 actually uses the term assigning, and therefore
25 Fotomedia knew when they wanted to assign a role, that

1 that would be different than associating or that would
2 not necessarily be coterminous with associate.

3 And as I mentioned before, there is just
4 simply no support in the specification for assigning a
5 list of users to roles.

6 THE COURT: The plurality of users?

7 MR. SHUMAKER: Correct.

8 The next term, associating the roles with
9 individual metadata elements.

10 THE COURT: Excuse me just a second. I
11 promised you I would warn you when you had used an hour.
12 You have used an hour and two minutes.

13 MR. SHUMAKER: Thank you, Your Honor.

14 So what are the issues with this term?

15 One, again Fotomedia believes there is no further
16 construction necessary. Two, the specification is clear
17 that roles may be assigned to groups of metadata
18 elements and not simply an individual metadata element
19 as discussed in the Defendants' brief. And three,
20 again, assigning a list of roles to metadata elements is
21 simply part of the preferred embodiment and is not
22 required.

23 In the interest of time, let me just jump
24 to the specification, and when the specification
25 discusses the invention, it discusses the invention in

1 context of roles and privileges associated with it, but
2 then it also uses an alternate embodiment. So the
3 argument that the term present invention somehow limits
4 the construction of this term to a list, is simply not
5 supported by the specification. The specification is
6 clear that the present invention is not a limiting term
7 whenever you read the present invention in context with
8 the language in the summary of the invention.

9 Secondly, I think it's worthwhile pointing
10 out that list is not required because if you look at the
11 claim language, there are dependent claims which
12 introduce the concept of associating a list with each
13 metadata element, thereby suggesting that a list of
14 metadata elements or a list of roles associating with
15 those metadata elements is not to be imported into the
16 construction of the term as found in the -- as found in
17 the independent claim.

18 Here we go, let me make sure I'm on the
19 right term here. Sorry, Your Honor, I skipped my slides
20 too fast here.

21 Okay. One more issue I want to point out
22 on this term. It's the Defendants rely upon an excerpt
23 from the prosecution history. And based on the
24 prosecution history, the Defendants argue that Fotomedia
25 disclaimed the use of somehow accessing metadata along

1 with the image. But interestingly -- I'm sorry, one
2 more time, that's actually in a different term.

3 In this aspect what the Defendants are
4 pointing to is the prosecution history which somehow
5 supports assigning roles to individual metadata
6 elements. And what I'd like to point out is that the
7 prosecution history doesn't relate to assigning roles to
8 individual metadata elements, what it relates to is the
9 fact that the prior art reference that was in front of
10 the examiner did not involve the use of an image with
11 associated metadata. It simply involved the use of an
12 image or image file stats, and therefore making the
13 argument that Fotomedia somehow disclaimed the use of
14 associating the roles to individual metadata elements
15 based on the prosecution history is simply a misread of
16 the prosecution history.

17 THE COURT: Do you have a problem with that
18 definition of metadata?

19 MR. SHUMAKER: No, Your Honor, we don't.
20 In terms of data that describes other data?

21 THE COURT: Or data about data? Which is
22 what -- as I read the applicant's statement it says,
23 that that's the common -- what -- he's distinguishing
24 prior art on the grounds that the prior art did not
25 concern metadata which is commonly defined as that.

1 MR. SHUMAKER: As data about data.
2 Correct. And, I mean, in that situation, I mean,
3 Fotomedia, I believe, would be okay with that
4 construction. Certainly we would like data about or
5 relating to the image.

6 THE COURT: Well --

7 MR. SHUMAKER: Or associated to the image.

8 THE COURT: -- that's not what your
9 patentee said. I mean, it could be a lot of data that's
10 related to other data, but that isn't metadata, is it?

11 MR. SHUMAKER: No, that's true. But in
12 terms of -- you're absolutely right, in terms of the
13 prosecution history, clearly the patentee defined or at
14 least suggested a definition for metadata as data that
15 describes other data or data about data.

16 So, yes, Your Honor, in answer to your
17 question, Fotomedia would be acceptable to the
18 construction of metadata based upon the prosecution
19 history.

20 The next term is request for access to the
21 metadata. The simple issue is is the request a request
22 for only metadata or can the request be a request for
23 the image and the metadata?

24 Well, the specification and intrinsic
25 evidence is fairly clear. The intrinsic evidence states

1 that the request can be a request for the image and the
2 metadata. Put up a section from the '231 patent, Column
3 4, and it states, highlighted, the user's request to
4 access the image and its metadata, which is a clear
5 support that the request can be a request for the image
6 and the metadata. And under the Defendants'
7 construction they would exclude that preferred
8 embodiment, which under law is rarely if ever correct.

9 THE COURT: Well, do other claims
10 specifically capture the concept of requesting both the
11 image as well as the metadata?

12 MR. SHUMAKER: Do other claims? Well, the
13 Defendants -- maybe -- I hope this addresses your
14 question. Let me make sure. So, if you look at --

15 THE COURT: Such that the preferred
16 embodiment is actually claimed, is my question.

17 MR. SHUMAKER: Oh, is the preferred
18 embodiment claimed as one of the independent claims, but
19 not claimed in all of the other independent claims, is
20 that what --

21 THE COURT: Or any of the dependent claims?

22 MR. SHUMAKER: I think the answer to that
23 question -- I mean, first of all, we would have to look
24 at the claim language. So, if we look at the
25 independent claims, let's look at Claim 25. Claim 25

1 talks about assigning roles versus associating roles.
2 And associating roles versus assigning roles would be
3 two different concepts, and -- I'm sorry, let me back up
4 because your question went to a different issue than
5 what I was going to talk about.

6 So, does this specification -- does the
7 claims claim a request for accessing the image and its
8 metadata? I would argue that no, it doesn't, because if
9 you look at the claims that are identified in the
10 Defendants' brief, they actually refer to claims that
11 differ in aspects lower than or beyond simply the
12 request as a request for the image, the request as a
13 request for the image and a metadata or the request as a
14 request for the metadata. And I don't see any support
15 where there is a straight claim differentiation argument
16 that the request in one of the independent claims was
17 merely a request for the metadata and nothing else.

18 And I would also mention that claim
19 differentiation is a presumption which can be rebutted
20 based upon the intrinsic record, and I put forth that
21 the intrinsic record provides no support for claiming in
22 one of the independent claims that the request is a
23 request for only the metadata. But there are certainly
24 other claims that claim requests for the image and are
25 requests for image and metadata, but that's not the only

1 difference between those claims.

2 The next term I would like to go into is a
3 user's role is determined from the request. The main
4 issue in this term is what information is used to
5 determine the role? From the Defendants' standpoint the
6 information must include or must be taken from the set,
7 that would be the user ID, class ID, group ID or
8 information about the access type.

9 Fotomedia argues that that's merely an
10 importation of the preferred embodiment into the claim
11 language in that the user's role can be determined from
12 information related to the request, but is not
13 necessarily limited to the specific types of information
14 identified in the Defendants' construction.

15 And that's the end of my presentation.

16 MR. KITCHEN: Thirty seconds of
17 clarification, Your Honor.

18 One is with regard to the question you
19 asked me regarding a card key, and I believe I
20 misunderstood the question. It is clearly the case that
21 in that example the card key uniquely identifies that
22 particular electronic postcard.

23 THE COURT: It's part of the URL, correct?
24 So, there would be a different URL created for modified
25 or regenerated postcards where the information had

1 changed, correct?

2 MR. KITCHEN: Correct, but that is just one
3 example. And as the Defendants point out in Footnote 18
4 of their responsive briefing, specifically this idea of
5 a card key as an identifier to a postcard is just one
6 example that is in the patent.

7 Secondly, with regard to the claim language
8 and whether storing satisfies process, I think the
9 position that is correct, Your Honor, and it's
10 consistent with the slide I showed you from the
11 preferred embodiment where we talked about the image
12 data, and the first step was to check the byte count of
13 the data, and the second step was the image data is
14 saved, and I referenced one as format and one as
15 storing. Our definition of process then would include
16 both a manipulation and a storage feature. And I think
17 that's consistent with the way the inventor has defined
18 the term. It includes both manipulation, formatting,
19 various types of formatting and storage.

20 Thank you.

21 We will retain the rest of our time,
22 please.

23 THE COURT: You have used an hour and 13
24 minutes.

25 MR. KITCHEN: Thank you, Your Honor.

1 MR. CHATTERJEE: Good morning, Your Honor.

2 THE COURT: Good morning.

3 MR. CHATTERJEE: My name is Neel Chatterjee
4 and I represent Photobucket in this case.

5 I thought I would start by giving a very
6 short agenda about kind of what we're going to try and
7 cover today. Given the amount of time that we have,
8 we're going to focus on a couple of the key terms that
9 we think the Court might benefit from argument. We do
10 -- we are prepared to talk about the other terms, should
11 Your Honor desire that, although we thought focusing
12 this would be helpful.

13 And because there are a lot of parties here
14 with a lot of different stakeholders, we've divided the
15 responsibilities. For the '774 and '936 patents, I'm
16 going to talk a little bit about the background of those
17 patents and a little bit about what the patents are all
18 about, and I will also discuss the server term, which
19 Your Honor had a lot of questions about, and the
20 associate term.

21 Mr. Partridge, who represents Yahoo, will
22 talk about the receiving image limitation, generate a
23 display, and the digital image.

24 And then Mr. Dunham, who represents some of
25 the cell phone carriers in the other case that is

1 consolidated for Markman, will talk about the term
2 computer.

3 We'll then proceed to the '231 patent and
4 my colleague, Gabe Ramsey, will give similar background
5 on the invention and talk about the roles and
6 associating roles and metadata elements terms.

7 And then Mr. Sacksteder, who represents
8 Shutterfly, will discuss the means-plus-function
9 limitations, and particularly the indefiniteness issue
10 under the Artisan case that has been fairly thoroughly
11 briefed by the parties.

12 So, I know that we have to break at 10:30,
13 Your Honor, and I'm going to spend about --

14 THE COURT: 10:25, we're going to take a
15 break in five minutes, but I want to go ahead and let
16 you start your argument.

17 MR. CHATTERJEE: Absolutely, and Your
18 Honor, just feel free to tell me when to stop. I'm
19 going to spend about 20 minutes talking about my terms
20 and the background total.

21 So, let's start with the background.

22 In our briefing the parties didn't really
23 say what one of ordinary skill in the art was in the
24 papers, and I noticed that as we were preparing for the
25 hearing. Our briefs were prepared from the following

1 perspective: That a person of ordinary skill in the art
2 for the '774 and '936 patents were a person with a
3 bachelor's degree in computer science, computer
4 engineering or the equivalent, and one to two years of
5 experience in developing client/server applications or
6 services for the Internet.

7 And that's the perspective from which we're
8 presenting our argument and that was presenting in the
9 briefs.

10 Now, the '774 and '936 patents which we
11 ironically refer to as the Mayle patents, but it's
12 M-A-Y-L-E, really is talking about an electronic
13 postcard. And in the presentations, one of the things
14 that I think is really a good governing example of what
15 they're really getting at when they talk about the
16 patent is what is shown in Figure 14 of the '774 patent.

17 And we actually see a document that looks
18 like a postcard. It has a picture on the front which
19 some handwritten text. It has written commentary on the
20 other side, a spot for a stamp and an address. And then
21 there is a vehicle to input the actual address to send
22 it. It actually looks like a physical postcard that one
23 might receive from a loved one that's gone on vacation.
24 The primary difference being is you need to have an
25 internet architecture to implement that.

1 Now, postcards, if you really think about
2 it and abstract it, have certain key attributes that
3 really find themselves in various ways in the patents.
4 The first thing about them is they are personalized,
5 they have a specific recipient in mind or a specific set
6 of recipients in mind.

7 The second is that they are unique. I
8 might send something different to my best friend from
9 college than I might to my grandmother.

10 They have text and images. One side will
11 typically have a picture or maybe even a series of
12 pictures on it, and then on the other side there will be
13 text, things that I have written.

14 And the final thing is that they have a
15 defined structure as you can see from Figure 14.

16 Now, this concept of the electronic
17 postcard is repeatedly referred to as the invention in
18 the patent, and it really is a driving consideration
19 throughout the patent, that implementation of these
20 attributes is really what the patent is getting at.

21 Just a few examples, although this happens
22 repeatedly throughout the patent, is they talk about the
23 figures. Now, when you look at the figures, they
24 repeatedly use the cadence the present invention
25 electronic postcard, or the flow charts of the steps

1 executed by a personal computer of the present invention
2 in creating the front and back of an electronic
3 postcard. And if you really look at what the
4 architecture is about, it's about the specialized way to
5 make sure you can send a personalized unique set of text
6 and messages from one person to another.

7 Now the way that they did this on the
8 patent was they implemented what's shown in Figure 2.
9 There is a personal computer operating system and then
10 there's a server computer operating system across the
11 network. And this picture is actually one of the
12 central attributes when you look at the claims that are
13 in dispute, particularly the server computer operating
14 system picture or part of the figure, number 31.

15 On one side you have a browser, something
16 that lets you access the web. You have a file system
17 where the photo file is stored, and you have a mail
18 reader, that might be something like a Microsoft Outlook
19 program.

20 On the other side you have the web server
21 software, that's the software that lets you communicate
22 with the personal computer. The mail server software,
23 that's the software that will send out e-mail messages,
24 the session database and the temporary image database.

25 Now, this is a very, very important

1 attribute in the concept of what the Plaintiffs'
2 argument is. What those two things do is they manage a
3 particular discussion going on between a personal
4 computer and a server computer at a given moment in
5 time. That is not really what the patent is talking
6 about when you look at the overall system architecture.
7 That's talking about when I access the web, and I go to
8 www.google.com, a session is created, and for that time
9 when I'm working on Google, there is a series of
10 communications that occur. But when the session ends,
11 that temporary image database, in the words of the
12 patent, and the session database are essentially no
13 longer useful and they would have to create a new
14 session for whatever new conversation occurs. The real
15 core of what the patent is getting at is the card
16 database and the image database, these are the things
17 that store all of the information that are necessary to
18 create the electronic postcard.

19 Your Honor, I betcha I'm at 10:30 right
20 now.

21 THE COURT: 10:25. We're going to take a
22 recess right now and take 20 minutes. Be back ready to
23 come in the courtroom at a quarter 'til 11:00.

24 COURT SECURITY OFFICER: All rise.

25 (Recess.)

1 COURT SECURITY OFFICER: All rise.

2 THE COURT: Be seated.

3 Continue.

4 MR. CHATTERJEE: Thank you, Your Honor.

5 Now going to the two terms that I am going
6 to be discussing, there are also several other terms
7 that I am prepared to discuss should Your Honor want it.

8 I'll be discussing the server claim and the
9 associate claim limitation. I can also discuss for Your
10 Honor, identifier, which is very closely related to the
11 associate limitation, card key and then the store
12 related limitations, store, storage device, storing, et
13 cetera. So turning to the server limitation, the
14 parties have construction dispute, you heard about it
15 before, where Fotomedia is asking for a construction of
16 one or more server computers, and we are asking that it
17 be construed as one server computer.

18 Now I think a good starting point here is
19 to talk about what the dispute is not about. It is not
20 disputed that there are numerous servers in the
21 architecture, we see that there. What is disputed and
22 the difficulty that is associated with their claim
23 construction is do all server based steps occur on each
24 physical device, one server computer. And I think Your
25 Honor really locked on to the issue when you asked the

1 question about the distributed system in 1996. Because
2 the distributed system as I understood Your Honor's
3 question is about do you have different devices
4 performing separate acts? And that is really what the
5 dispute's about as far as this claim construction goes.

6 Now, Claim 1 of the '774 describes it, it
7 uses the term a server and then later on uses the server
8 and it describes what all of those steps are.

9 Now Your Honor asked an important
10 question of opposing counsel during their argument which
11 was when they use the term a here and they use the
12 phrase at least one in other places, isn't there a
13 difference, when they knew how to draft things when they
14 meant more than one. And I think the answer to that is
15 yes. They knew how to draft at least one and they used
16 it repeatedly in the '774 and '936 patents, and
17 sometimes they did it in the exact same claim, other
18 times they did it in dependent claims. They didn't do
19 it with respect to the server though. The server was
20 always a single unitary device. And the only place
21 where all of the limitations of Claim 1 is met, for
22 example, are in that server computer operating system.

23 As far as the server based steps, there
24 is obviously another dispute as to how the uploaded data
25 works and what step occurs there, is that on the user

1 computer or the server? But all of the server based
2 steps of Claim 1 are occurring on that aspect of Figure
3 2, the server computer operating system, and all of
4 those are a single physical box.

5 How do we know that? The way we know
6 that is to first take a look at the state of the art at
7 the time that they described in Figure 1 of the patent.
8 And what they did is they tried to lay out the basic
9 topology of a network, that is how they described Figure
10 1. And you'll see that there is a PC connected to a
11 modem and a service provider that works through the
12 worldwide web to communicate with the server.

13 Now, there is a very important thing that
14 is not on this picture. You will see I took each server
15 and I colored them yellow. There aren't lines between
16 those servers. The state of the art did not have this
17 distributed architecture where you could connect
18 different servers together to each perform one function.
19 Instead what they taught here is you have a PC engaging
20 with a server to transmit, upload files, manage the
21 links and the like, it was a one-stop-shopping box. And
22 this server is basically reflected in what's in Figure
23 2.

24 Now, not only does the basic architecture
25 of the system that they talk about in the patent support

1 this notion of a single server, they also responded to
2 an office action where they said the same thing in the
3 file history. And in response to an office action they
4 made some remarks at the beginning. It wasn't
5 responsive to any particular thing that the Examiner had
6 identified, they just had an opening remark about what
7 their presently claimed invention was, and this was the
8 very first statement they made. And this section is
9 actually quite important because we're going to turn
10 back to it when we talk about the associated term.

11 But what they said was, a user of the
12 system transmits data encoding a digital image, an
13 address for a recipient, an optionally other data such
14 as a personal message to a server, and the server sends
15 a message to a specified recipient a message identifying
16 the uploaded image.

17 Once again, just like Your Honor noticed,
18 they didn't say one or more servers, they didn't give
19 any indication of having a distributed file architecture
20 where you could do different things on different types
21 of servers, instead they limited it to one.

22 Fotomedia acknowledged this in their
23 brief. They said, the preamble of Claim 1 is clear, it
24 states that the recited steps are performed by the
25 server. And indeed, the patent has no teaching of a

1 disaggregated function across devices.

2 Now, I had the opportunity to depose Neal
3 Mayle, who is the inventor of the patent. Now, when he
4 filed for this patent, he was considerably beyond one of
5 ordinary skill in the art. He has a PhD from MIT, he
6 has a strong background in computer science. And I
7 asked him, when he drafted the patent and participated
8 in that, does the patent teach anything about how to do
9 things across multiple devices, have this disaggregated
10 function? And he answered, I believe we described how
11 to do it with a single machine.

12 I also asked him -- and this goes to your
13 enablement point, Your Honor -- well, why didn't you do
14 it on different devices? Why didn't you have -- because
15 all of these services, he said, were available through
16 different internet companies or other sorts of companies
17 -- I said, why didn't you just connect them together?
18 And here's what he said. He said, they weren't built to
19 work together. There wasn't even the idea that they
20 could work together, each one had to be specifically
21 tailored to work together.

22 Now, Your Honor asked the question about
23 enablement, I think this statement by Mr. Mayle is an
24 admission that the patent does not enable the
25 disaggregated functions. However, when you're looking

1 at enablement in claim construction, I think there is an
2 obvious interplay between the two. The interplay is
3 what would one of ordinary skill in the art in reading
4 the patent understand that it covers? What Mr. Mayle
5 said here is that it wouldn't cover this disaggregated
6 function across multiple servers. It would be a
7 one-stop-shopping box, and that's what's taught by the
8 patent, and that's what one of ordinary skill in the art
9 would understand it to mean.

10 THE COURT: How difficult would it have
11 been in 1996 to farm out the message sending function to
12 a separate server?

13 MR. CHATTERJEE: That was essentially the
14 question that I asked right here of Mr. Mayle, and he
15 said it would be very hard, they weren't built to do
16 that.

17 Now, there is also some extrinsic
18 evidence that supports this, that are statements that
19 Fotomedia made in a Canadian prosecution, and obviously
20 this is extrinsic evidence, it is a foreign prosecution.
21 But what they said there, they sought a virtually
22 identical Claim 1 to the Claim 1 that they have in the
23 '774 patent here, and when they were disputing some
24 rejections in the Canadian Patent Office, they made the
25 following statement: The server in Claim 1 can no more

1 be equated to an entire WAN, that is a series of servers
2 connected together, as a newspaper stand can be equated
3 to the collection of all retail stores in a country or
4 world and the associated interconnecting roads.

5 I struggle with how I could have said it
6 better myself, that the retail stores in their metaphor
7 would be numerous special purpose devices that were
8 connected together through the interconnecting roads.
9 But they said to the Canadian Patent Office, that is not
10 what we're trying to do in this patent. We're trying to
11 have one-stop-shopping place for our activity.

12 THE COURT: In the questions that you
13 were asking the inventor, were you focusing on the
14 message sending aspect or were you talking more in
15 general about disaggregating all of the functionality in
16 Claim 1?

17 MR. CHATTERJEE: I asked him about all of
18 them, and I did ask him about e-mail. I don't remember
19 the exact question I asked him about that, but he did
20 say that there were external e-mail services, and I do
21 remember asking him a question such as, well, why didn't
22 you just do some sort of programming code to interact
23 with that rather than creating something new? And my
24 recollection is, Your Honor, and it might be slightly
25 faulty, was that like everything else, he said, it would

1 require a lot more effort than just doing it on a box.

2 THE COURT: It would require a lot more
3 effort, but would it require undue experimentation?

4 MR. CHATTERJEE: So, Your Honor, the only
5 thing that he said in that regard was they weren't built
6 to work together, there wasn't even the idea that they
7 could work together, and he was talking about all of the
8 functions.

9 THE COURT: Right, and my question to you
10 is how difficult would it have been in 1996 to farm out
11 the message sending functionality to a separate server?

12 MR. CHATTERJEE: I think that the same
13 problem would exist, it would still be very difficult to
14 do. Because you would have to have some sort of way to
15 have the database of the system that is in the patent
16 engage with an e-mail service and provide all of the
17 information about how the database worked. You would
18 have to have some sort of way to handshake the two, and
19 you would have to figure out -- you couldn't customize
20 your e-mail service at all, you'd have to figure out how
21 do you interface with that e-mail service.

22 And my son says and what Mr. Mayle said
23 is it would be a very difficult thing to do.

24 Going to the next term is associating.
25 So, Fotomedia's construction is talking about relating,

1 and ours is really directed toward specifically and
2 uniquely relating.

3 Now, here is the fundamental issue. The
4 issue is not about whether multiple images can be
5 identified through a single link. I think Your Honor
6 asked a question about that, is that you could have one
7 identifier identifying a series of pictures that are all
8 coupled together in a photo album.

9 THE COURT: On the same web page, for
10 instance.

11 MR. CHATTERJEE: On the same web page,
12 but there is an important distinction in that regard.
13 The question is is whether the link is uniquely tethered
14 to one or more images. And the reason why that is
15 important is is you can think about the Pacer website
16 that the Court has. I could send a link whenever
17 someone did a new filing, and the link would just
18 identify the Pacer website. And that would relate at
19 some level to any new docket entry that had been filed.
20 It would relate to it because the information was stored
21 on there.

22 Or I could send a link from the Pacer
23 system that was specifically correlated to a docket
24 entry, where when I clicked on the link, it would pull
25 up the brief from whatever document had been submitted

1 by the Court. That is uniquely related. And you can
2 even see that example when you do an e-filing with maybe
3 five exhibits to a declaration. Because when I click on
4 the link, it pulls up the web page that has those five
5 different pieces put together.

6 And this concept of uniqueness is really
7 something that the patent is very focused on when it is
8 talking about associating an identifier. We see an
9 example of it here in Claim 1 of the '774, associating
10 an identifier of the stored image data. This is really
11 going beyond just accessing the Pacer website. It's
12 really talking about accessing something like a docket
13 entry.

14 And if you look at the patent in the
15 summary of the invention, they repeatedly and
16 consistently talk about this identifier being unique.
17 And that concept of uniqueness really only comes about
18 through the term associate.

19 Now the Plaintiff doesn't like that term,
20 but the reality is is that throughout the invention and
21 throughout the description all of the preferred
22 embodiments, the summary of the invention and elsewhere,
23 they are always talking about the identifiers having
24 this unique relationship with the specific image. And
25 actually hearing their argument today, I think they

1 actually agree with that, but they are trying to use a
2 much broader term related to, so if I were to just go to
3 Google's website by clicking on a link, that would
4 somehow be considered infringing. And it's simply not
5 the case that that would be consistent with the language
6 of the claim.

7 Again, in the presently claimed invention
8 office action, they said that the message identifies the
9 uploaded image. It is again this very close tethering
10 between the notice -- I will use the term link, they use
11 the term identifier or URL, but it is a very close
12 tethering between the URL and the image itself.

13 And then finally, Your Honor, unless you
14 have questions on the other terms, I just want to talk
15 -- I just want to mention three cases that -- to the
16 extent that Your Honor has not yet had a chance to look
17 at it, that I think are very important in the context of
18 this analysis.

19 One is the Norian case which Fotomedia's
20 counsel mentioned earlier. The second is the Netcraft
21 vs. eBay case that really is the most current state of
22 the law on the use of the term the present invention in
23 a patent and how that affects claim construction. And
24 then the final one is Kinetic Concepts Vs. Blue Sky
25 Medical, which really talks about when you only disclose

1 certain attributes in an embodiment, it can be limiting
2 on claim construction. And to the extent Your Honor has
3 not had a chance to look at those yet, I wanted to
4 highlight those three cases.

5 So, unless you have questions on the
6 other terms, I would like to hand it over to Mr.
7 Partridge.

8 THE COURT: I don't.

9 MR. CHATTERJEE: Thank you, Your Honor.

10 MR. PARTRIDGE: Good morning, Your Honor.

11 THE COURT: Mr. Partridge.

12 MR. PARTRIDGE: I am going to speak for
13 20 minutes, and then turn it over to the next lawyer on
14 our side. Hopefully we can all stick to our time
15 allocations.

16 I am going to talk about three terms,
17 Your Honor, the receiving image data term that counsel
18 for Fotomedia addressed, as well as generate a display
19 term, and thirdly the image data and the digital image
20 term. I will be very brief as to that one.

21 The three other terms that I am prepared
22 to discuss if you have questions, the term process for
23 which there was some dialogue between you and counsel
24 for Fotomedia, as well as the timing of the associating
25 step, and I may say a few words about both of those in

1 connection with the questions that you asked earlier
2 this morning.

3 The electronic postcards in a dependent
4 claim, no one has addressed that, I will not address
5 that this morning unless you have a question about it.

6 Turning to the first term, receiving
7 image data embodying an electronic image, the image data
8 transferred under control of the user at the sending
9 computer. Fotomedia proposes no construction, and of
10 course we do. And as counsel for Fotomedia underscored
11 and as evident from the very question you asked, Your
12 Honor, yes, we do contend that there is an active step
13 here of the user of the system actually sending the
14 image data to the server. And I'll explain why that's
15 an appropriate construction here.

16 THE COURT: Why isn't the claim
17 appropriately limited to the receipt of information that
18 has been sent by a user?

19 MR. PARTRIDGE: And there are three
20 answers to that question, Your Honor, and it actually
21 comes up in my first substantive slide.

22 Why construe this at all which is
23 essentially the question you're asking? And the first
24 answer to that question, and I will explain how it
25 applies, is that the applicants added this language to

1 the claim to overcome the Wright patent. And we will
2 look at Wright and see what the implication is of that
3 amendment to the claim relative to Wright. And by this
4 amendment we contend they actually disclaimed the
5 argument they are making to you which is these are only
6 server steps. And thirdly, when you actually look at
7 the language that was added by itself, it's ambiguous on
8 its face, Your Honor, and it requires a construction in
9 order to know what it means, and you can only get there
10 by going to the prosecution history and looking at the
11 prior art which is a function for Your Honor rather than
12 the jury.

13 So it is useful, Your Honor, I happen to
14 be reading the Graham V. John Deere case recently in
15 connection with another matter, I hadn't read it in a
16 few years, and I found this in Graham V. John Deere that
17 fits the very points we're raising here, and what they
18 said in that case is: Claims as allowed must be read
19 and interpreted -- the Supreme Court is saying this --
20 with reference to rejected ones and to the state of the
21 prior art. And it goes on to say that claims cannot be
22 sustained to cover that which was previously by
23 limitation eliminated from the patent. And this is the
24 point of the construction we're raising here.

25 | So what did the applicants actually do?

1 Well, to get the patent, they had received a rejection
2 based on the anticipation over the Wright reference, and
3 they made an argument and they said the system of Wright
4 teaches selecting a greeting card image stored on a
5 central image server. And they said the presently
6 claimed invention is directed to a system wherein the
7 image data is created by the sender and not selected
8 from a selected -- a pre-existing list of greeting card
9 images.

10 This argument occurred before they
11 actually amended the claims. And what happened at this
12 point in time is that there was an interview between the
13 applicant, applicant's counsel and the patent office.
14 Unfortunately, contrary to the rules at that time
15 neither the applicant nor the Examiner said what
16 happened in that interview, but the end result of that
17 interview was the language that we see in the claim, and
18 the underscored language is what was added. The image
19 data transferred under control of the user at the
20 sending computer. And then the phrase about image data
21 either residing in the sending computer or a source
22 separate from and in communication with the sending
23 computer. That is the language that they added that
24 then resulted in allowance over the Wright reference
25 which was used for anticipatory purposes.

1 Now it is interesting when you go back
2 into the specification and you look at how they
3 characterize this invention, and you go to the
4 background of the invention, and the very last sentence
5 after they have talked about what preceded is this:
6 None of the current mechanisms allow the user to
7 transfer -- the user to transfer a digital photograph to
8 a server where it is then processed, et cetera.

9 They further say in the specification, in
10 the last section of the specification there is a portion
11 of it entitled variations. And within that section
12 entitled variations, they talk about the preferred
13 embodiment and some modifications to the preferred
14 embodiment which really consist of only adding more
15 photographs, a baby album, a family album, but it
16 doesn't change the nature of the invention one bit, and
17 they describe this as the full scope of their invention,
18 and they characterize the present invention at that
19 point as requiring the user to upload image information
20 for processing by the server. So this is what we get
21 from looking at the claims, now looking at the
22 specification.

23 Now let's see what happened in connection
24 with the rejection over Wright. I think that there are
25 a couple of points that are clear and really aren't

1 subject to debate here. The applicants intended to
2 distinguish the operation of Wright's server with what
3 they did because of that rejection. We would contend
4 that Fotomedia's argument results in no difference
5 between the operation of Wright server and the claimed
6 server. Why is that? They seem to be saying that it is
7 enough of a distinction with respect to a claim that is
8 directed only to the method of operation of a server
9 that the retrieved information is in the nature of an
10 image that somehow got there from a user, but the steps
11 of the server in Wright are the same with their
12 construction. There is no difference in the application
13 of Wright to this claim if it is limited to the server
14 than it was before the amendment was made. The amended
15 claim if only directed to the nature of the transferred
16 image doesn't say anything about the nature of the
17 operation of the server itself.

18 We contend the addition of the sending
19 step by the user is what actually distinguished Wright,
20 and why is that? Let's take a look at Wright itself.
21 And, Your Honor, I realized in preparing this morning
22 that we had not given you a copy of Wright, obviously
23 you can find it yourself on the system, but I have a
24 couple of copies if you would like me to hand them up
25 this morning.

1 THE COURT: I would.

2 MR. PARTRIDGE: So, now looking at
3 Wright, what did Wright have? Well, I first said my
4 third point was that transferred under the control of
5 the user could be ambiguous unless it is construed by
6 you. Well let's look at why that is the case.

7 Wright disclosed an electronic greeting
8 card system in which a user, the sender or the personal
9 communicator, communicated with the server which was
10 connected to an image library. That is what's disclosed
11 in Wright. And if you will remember in the claim
12 language, they added this phrase -- go back to the first
13 slide in this series which shows the -- yes, this one
14 right here.

15 If you -- when you look at this phrase it
16 says, or the image source separate from and in
17 communication with the sending computer as an
18 alternative to the image coming from the sending
19 computer. When you go back to Wright, if that language
20 is not construed in the context of a user uploading an
21 image, then the sender at a personal computer
22 communicating with a server and asking the server to
23 withdraw from storage -- from the image library, which
24 is this other source, an image, is not distinguished
25 over Wright.

1 Let's walk through this a little bit. So
2 Wright's library could be an image source separate from
3 and in communication with the sending computer as
4 recited in Claim 1. In which event, the sender commands
5 a transfer from the storage device connected to the
6 server of Wright, and then that card is delivered to a
7 recipient. There is no difference between that claim
8 because of the alternative language in the phrase and
9 Wright, if you use Fotomedia's construction.

10 So what was intended here by the change
11 to the claim? It can't be Fotomedia's construction
12 because then the patent is -- the claim is unpatentable
13 over Wright, it doesn't distinguish Wright. So there
14 must in fact be the active sending by the user of an
15 image in some form, and the language that we have
16 crafted does exactly that. That would be an arguable
17 distinction over Wright, which Graham V. John Deere says
18 you have to look at the rejected claim versus the
19 allowed one compared to the prior art and determine
20 whether or not there is something in what was added to
21 change the claim when they gave up the original scope
22 that distinguishes that claim over the prior art. And
23 this is the only thing that arguably does that.

24 THE COURT: If the -- can you go back to
25 that slide, please?

1 MR. PARTRIDGE: Sure.

2 THE COURT: If the claim is construed as
3 receiving at the server the image data sent by the user
4 from the sending computer, wouldn't that overcome
5 Wright?

6 MR. PARTRIDGE: Could you say that again,
7 Your Honor?

8 THE COURT: Receiving at the server data
9 the image data sent by the user at the sending computer.

10 MR. PARTRIDGE: You still -- when you
11 look at the claim as a claim directed then only to the
12 server, the operation of the server of Wright is still
13 identical to the claim. The only difference is that it
14 is now operating on a different piece of data. Instead
15 of having a photograph of the Statue of Liberty, it is
16 now a photograph, a picture, you know, I took of my
17 family. There is no difference in the operation of the
18 server itself. If the claim is limited to the steps
19 carried out by the server, then there is no difference
20 between that construction and what Wright discloses.

21 THE COURT: Except the server in Wright
22 didn't operate on image data that was sent by the user.

23 MR. PARTRIDGE: Well, you know, actually
24 even that point is debatable, Your Honor. When you look
25 at Wright -- if you look at Column 7 of Wright, top of

1 the column of Wright says -- and he talks about personal
2 messages that are created by the user of the system and
3 says, the message that he just described which would be
4 the message that would be inside the greeting card that
5 is sent, just examples of personal messages that a user
6 can attach to the electronic greeting card and other
7 types of input devices, 114, may be used to enter a
8 personal message which is coupled with the electronic
9 greeting card for sending to a party. So that Wright
10 actually talks about uploading from the sending computer
11 data to be included in the greeting card that is then
12 sent to the receiver.

13 THE COURT: Image data?

14 MR. PARTRIDGE: It says it can be any
15 kind of a device, and as we know -- any kind of device,
16 114.

17 THE COURT: I know, but the data, is it
18 image data?

19 MR. PARTRIDGE: He does not specifically
20 say image data, he says any kind of a device. And as
21 you know, from the patents that are at issue here, those
22 patents say that hooking up a video camera, a scanner or
23 anything else, it was a simple matter to do. In fact,
24 the only disclosure of that is just the drawing that
25 depicts those blocks.

1 So, you know, I don't think the question
2 you asked results in a difference in the actual
3 operation, the steps of the server, the steps that are
4 recited in the claim, and the only thing that one can
5 argue might distinguish Wright is if the user is
6 uploading image data to the server to then be used at
7 the server through the operation of a program to create
8 an image to be sent to particular recipients.

9 Go to Slide 17.

10 So our point is, Your Honor, while the
11 original rejected claims actually addressed server
12 functions, it is true, it was a list of server
13 functions, the amended claims no longer cover only
14 server functions. The server language in the preamble
15 cannot outweigh the added language of the claim that
16 requires a user to send the electronic image to the
17 server to be processed.

18 And, in fact, they can't really have it
19 both ways, and the courts have recognized this, in the
20 North American Container case cited in our brief, the
21 court preserved an inconsistent use of a term -- it was
22 actually in the same claim, where a term was construed
23 one way for one purpose in the claim because there was
24 prosecution history related to that in which an
25 amendment was made of that term, and the court said,

1 well, that term has to be construed more narrowly as a
2 consequence of that, but the same term used elsewhere
3 was not construed in that same way. And the court said
4 that in that instance prosecution history in an
5 amendment to a claim to obtain allowance controls. And
6 so the language in the preamble that says the server
7 carrying out the following functions, does not trump the
8 fact that that claim was amended to add a user sending
9 the image to the computer. That language trumps the
10 language in the preamble of the claim.

11 So turning next to the generate a display
12 limitation, Your Honor. Unfortunately in the briefing
13 this term was separated and Fotomedia's argument
14 separates the terms. They really go together. I don't
15 think you can look at generate and then look at display.

16 THE COURT: I understand your argument
17 was you wanted a construction of generate a display.

18 MR. PARTRIDGE: That is correct, Your
19 Honor.

20 And let's go through why that
21 construction is proper. When you look at Claim 1, it is
22 true that it is a system claim, but it only has one
23 element. It is a server. The server includes amongst
24 a list of sub-elements a CPU. When you look at the CPU
25 limitation, it is described entirely as a program. It's

1 a method. It's A, B, C, D method steps.

2 And so let's look at the overview of the
3 claim, functional steps of the CPU, input user
4 information, store the user information, process the
5 image data, generate a display including at least a
6 portion of the processed image data, associate a URL
7 with the display. Those are steps. And the step of
8 generating a display follows the processing step and it
9 precedes the step of creating the URL. And your
10 question earlier this morning about can you create a URL
11 when you don't have a display? Well, they don't do that
12 in any of the embodiments, as counsel admitted when
13 getting up the second time to discuss that issue, and in
14 the claim itself it provides a structure for generating
15 both the display and then associating a URL which
16 grammatically follow each other.

17 But the point of this really turns over
18 how display -- how a display is generated in this
19 system. It is in our view more than merely image data.
20 It's fixed and it's a visual representation.

21 The Phillips case, as you know,
22 identifies a couple of situations in which the
23 specification can be used to limit the claims. One of
24 those is when the applicant acts as his own
25 lexicographer, we think that is applicable here. And

1 the second is when the patentee intends for the claims
2 and the embodiments in the specification to be strictly
3 coextensive, we think that is applicable here as well.

4 Turning to the first, the abstract, and
5 this is the abstract as written originally in this
6 application, and they kept it the same in both patents
7 throughout, and the abstract itself defines the display.
8 This is not in the briefs, Your Honor, it should have
9 been, but here is the definition of display: Comprising
10 a mixture of image and textual data. They defined it,
11 image and textual data.

12 In the specification, again in that
13 variation section where they summarize the nature of the
14 preferred embodiment and the other embodiments, the
15 present invention requires the user to upload image data
16 that is processed by the server into a display for
17 viewing. It is all about creating a display for viewing
18 according to the present invention.

19 And, in fact, when you look at the
20 specification, that is actually what happens. Message
21 is created, an image is added, a caption is added to the
22 photograph. And this is in Figure 11 what is meant by
23 generating a display. The display is generated by the
24 user at the server, and this is what it looks like.

25 In the specification at the conclusion of

1 that set of figures, there is a discussion of the
2 resulting image. It is compressed, converted into an
3 image format, viewable in a web browser such as GIF or
4 JPEG, fixed images, Your Honor. That is what those are.

5 The display is visual. It is not a
6 series of binary digits. It is something for viewing.
7 The claim says that, generate a display, a display that
8 is available for viewing to allow the at least one
9 recipient to view the display using the URL. It is
10 something for viewing.

11 It is not even a description. A
12 description is not the display. You can describe what's
13 in the picture, but the picture is the display that the
14 patent is talking about.

15 So Fotomedia's construction that it is
16 data that may be viewed ignores the definition in the
17 abstract. It ignores the present invention statement.
18 It ignores the description of how fixed displays are
19 created, and those are the only types of displays
20 described in the entire specification. And it ignores
21 the claim requirement of viewing.

22 And what do we get in the reply brief?
23 There is this straw man of blinking which probably
24 doesn't demand much explanation, but I will say that the
25 spec says nothing about blinking. JPEG and GIF files

1 are by their nature fixed, and even a blinking function
2 has to do with the rate at which a fixed JPEG and GIF
3 file is displayed.

4 And even if you get to the point of
5 looking --

6 THE COURT: Are -- excuse me. Are JPEG
7 and GIF files fixed always?

8 MR. PARTRIDGE: In the context -- in the
9 specification they describe a series of steps that gets
10 to a JPEG, two JPEG and GIF files. One of which is
11 stored in that image database and the other is stored in
12 that card database. Those are both fixed images, stored
13 there that are then accessed directly as Mr. Chatterjee
14 described by the URL. Is there some technical situation
15 where a JPEG or GIF file could not be fixed, I am not
16 aware of it, Your Honor, but I'm not enough of an expert
17 in that to give you necessarily the correct answer.

18 And the last thing I wanted to talk about
19 very briefly is the digital image, the image data which
20 we say should be construed, that it is the uploaded
21 unprocessed image data. That is what we say. And
22 unprocessed is in there not because we're trying to read
23 something into the claim, but it is because of what they
24 want to try to argue about a claim that clearly is
25 addressing a digital image that has not yet been

1 processed, and you can tell that from looking at the
2 claim itself.

3 Method Claim 8 of the '936 begins with
4 allowing a user to upload a digital image, and then
5 referenced throughout the patent to the digital image,
6 throughout. It is referencing back to the very same
7 thing. This is a basic antecedent basis issue, Your
8 Honor. And I would add if we can go to the ELMO with
9 respect to the issue raised by counsel about
10 unprocessed.

11 This is Claim 1 of the '936 patent, Your
12 Honor. And here we see that it refers to an electronic
13 image data, process the electronic image data. And the
14 key here is, Your Honor, when they wanted to talk about
15 process the electronic image data, they knew how to put
16 it in the claim. So, in some claims they really meant
17 processed electronic image data, and in other claims
18 they did not. And so in the claim that I used as my
19 example where we think antecedent basis law controls,
20 the construction of that ought to be the unprocessed
21 image that has been uploaded by the user.

22 And, Your Honor, I have burned a little
23 more time than I intended, but I think it is just worth
24 noting a couple of things that came up on those other
25 terms.

1 It is interesting with respect to
2 associating a URL with the display. You asked the
3 question does the spec show creation of a URL before the
4 display, and the answer was nothing indicates that it
5 could not be. That is correct, Your Honor. There is
6 nothing in the spec that suggests otherwise, but more
7 importantly the claim structure itself grammatically and
8 consistent with the specification requires that the URL
9 is created after the display has been generated. The
10 claims don't talk about regeneration, they don't get
11 into a session operation where one might be refreshing
12 either the URL or refreshing the display, they talk
13 about the generation of the display by the user in the
14 first instance.

15 The other thing I would point out, Your
16 Honor, the other side cited the Creative Internet case,
17 that case involved apparatus claims. We're talking
18 about method steps here. It is not applicable to the
19 method steps that are addressed by this particular
20 limitation.

21 The last issue concerns the issue of
22 process -- excuse me, processing and storing, that was
23 the issue. And as I think you pointed out in your
24 question, the claim has a step for storing and a step
25 for processing. It is the claim that then controls.

1 The claim says what storing is and it says separately
2 that the thing that is stored is then processed. You
3 cannot get around that distinction by talking about what
4 may temporarily happen in a buffering and in a temporary
5 storage process when a CPU is carrying out a
6 manipulation operation, and for some moment in time
7 something is stored in some storage register during that
8 manipulation process. That is not what storing and
9 processing are about in this claim.

10 And the reason we say processing does not
11 include storing in the claim is because storing is
12 separately stated as a step and element of the claim.

13 Thank you, Your Honor.

14 MR. DUNHAM: Good morning, Your Honor.

15 THE COURT: Good morning.

16 MR. DUNHAM: My name is Tom Dunham, and I
17 represent three of the Defendants in the Alltel case,
18 that's Verizon Wireless, Sprint and Alltel. And I'm
19 here to discuss a couple of terms from the '774 and '936
20 patents. I'll be focusing on the computer terms, but if
21 the Court has questions on the browser term or the
22 message and message address terms, I would be happy to
23 address those as well.

24 The main dispute with the computer terms,
25 and the word computer appears in several places,

1 Fotomedia has proposed a very generic construction.
2 That a computer is a device having a processor for
3 processing data. And the Defendants contend that the
4 computer terms are more properly limited to a personal
5 computer.

6 If I may, I would like to take one second
7 and explain why this is important, and it really relates
8 to the fact that the Defendants in the Alltel case are
9 cell phone providers, service providers such as Verizon
10 Wireless.

11 THE COURT: So, you would be happy with
12 any construction of computer that said a computer other
13 than what might be found on a cell phone.

14 MR. DUNHAM: That is correct,
15 essentially.

16 THE COURT: Right? Okay.

17 MR. DUNHAM: But let me explain why, and
18 it's not just that that's what I'm seeking, but I will
19 be honest with you. If we can take the ELMO here and
20 look at the first page from Fotomedia's actual opening
21 brief.

22 Did you zoom this in? Ah, here we go.
23 Let me back up here.

24 This is the first page of the opening
25 brief from Fotomedia, and in what they describe as the

1 overview of the patented technology. They have done
2 something that I think is very interesting here. They
3 give an example of the invention, they say, a website
4 communicates image information with the sending and
5 receiving computer, which they go on in the
6 parenthetical to say it could be a camera phone, a
7 personal computer, the word that they don't like in
8 their brief, personal, a PDA, et cetera, any computer
9 device that can transfer images to or from a website.

10 And notice that they try to back away
11 from the word computer and now what they want to do is
12 call it a computer device. I think they recognize right
13 from the start that there is no disclosure in the '774
14 or '936 patents of any sort of cell phone or PDA, it is
15 all about computers. And in the opening section of
16 their brief, they try to sort of obscure this issue by
17 referring to camera phones and personal computers and
18 PDAs as if they are computers and then they back away
19 and refer to them as computer devices.

20 THE COURT: How does the patentee account
21 for improvements that might be made in the future?

22 MR. DUNHAM: Well, I think that's an
23 interesting question, and if I can toggle back -- we can
24 go back to the slides here.

25 The background of the specification, I

1 think, is instructive in part on this point. If we look
2 at what the inventors did, they explained what advances
3 in technology had permitted them to undertake the work
4 that they did to create their electronic postcard
5 system. And I have two quotes here out of the
6 background that are important. First, the inventors
7 acknowledged that there were certain advances relating
8 to digital photographs and digital photography that made
9 their work possible. One was the penetration of
10 powerful personal computers in the home environment.

11 Now what they do is they describe some
12 preferred embodiments, sort of the minimum requirement
13 that would be necessary and they explain it right here.
14 They say, these new computers can run complex processing
15 applications. They typically have a 32-byte processor,
16 a large memory array, high capacity mass storage, high
17 res color monitor and a fast modem. In essence what
18 they have done is they have drawn a line in the sand,
19 and they say, we need this to implement our invention at
20 a minimum.

21 So, to the Court's question, for advances
22 in technology what they are saying is if you have
23 something more advanced than this, more powerful than
24 this machine, they contend that their system would still
25 operate with that type of technology. And that is how

1 they have accounted for advances in technology, but they
2 have drawn a line as to the base line. We have to have
3 at least this. They also go on in the background, and
4 this is not in any preferred embodiment, but the lower
5 quote explains how the system would work. It says, the
6 events have created a situation where an individual at
7 home can download images captured by a digital camera or
8 a scanner into their home computer, connects the web and
9 transmits the picture on. What they don't say is you
10 can use some other device. They certainly could have if
11 they had thought of it, described using a device other
12 than one of these home computers to download images from
13 a digital camera or to somehow place those images on the
14 internet. They didn't do that because it is not
15 something that is disclosed in the patent. I submit it
16 is not something that they had contemplated.

17 THE COURT: What technology existed in
18 1996 to that extent?

19 MR. DUNHAM: In 1996, 1997 certainly the
20 state of the art would be similar to what is described
21 here in terms of home computing capabilities, a 32-byte
22 processor and sufficient memory and displays.

23 THE COURT: Integrated digital camera and a telephone?

24 MR. DUNHAM: Really was not something
25 that had been developed in 1996.

1 THE COURT: A telephone with browser
2 capabilities.

3 MR. DUNHAM: Again, not something
4 existing in 1996, not surprising that it's not
5 disclosed. In essence, Fotomedia can point to no
6 disclosure in the patent suggesting even remotely that
7 the inventors thought of using anything else other than
8 a computer, and a computer meeting certain base line
9 requirements. Certainly in 1996, 1997 to the extent you
10 could even find a non-computing device that took images,
11 it would not be meeting these types of requirements.

12 If we look at the embodiments that are
13 described in the patent further, I think it is even more
14 instructive. With reference to Figure 1, and we have
15 just placed part of it before the Court here. It shows
16 a personal computer, I don't think it's by mistake that
17 it's labeled a PC, and the inventors explained, that's
18 their present invention. As Mr. Chatterjee explained
19 earlier, it is a personal computer that can receive
20 input information here shown from an electronic camera
21 or a video recorder, and then can output that
22 information. There is shown a modem to communicate with
23 a network or the world wide web. There is a printer
24 there and another device, maybe a scanner, it's a little
25 hard to tell.

1 Further with regards to Figure 2 in the
2 patent, this is explaining what the software
3 capabilities of the personal computer would have to
4 have. This is similar to the background of the
5 invention where the inventor said certain advances in
6 technology have established a base line that is
7 sufficient for us to do our work in generating and
8 creating these electronic postcards. Now we look at
9 what has to be from a software perspective included on
10 that computer. Figure 2 shows us, the personal computer
11 operating system has to support a browser, has to
12 support some sort of file system that can store the
13 files and have some sort of mail reader, and that's to
14 interact with the network and to send and receive e-mail
15 messages. Again, this is not the type of technology
16 that would have been found in PDAs or cell phones back
17 in 1996, 1997, and I believe that is why it is not
18 disclosed in the patent. There is no mention whatsoever
19 of it.

20 Going on with the description in the
21 patent of the invention, there is references to how the
22 computer operates, Figure 3a and Figure 3b are two flow
23 charts and they again refer to the steps that are
24 executed as described in the patent by the personal
25 computer of the present invention. It is clear that

1 every time the inventors talked about a computer, they
2 talked about a PC or a personal computer, and they had
3 established a base line for the requirements of that
4 computer unambiguously in the background section of the
5 patent.

6 Describing a little bit further the
7 operation of the invention, the patent goes on to say,
8 well, here is how it works. The computer may interface
9 to a variety of peripheral devices, and I think this is
10 a point that is very important. The notion of the
11 computer being able to interface with other peripherals
12 again is fundamental to the implementation of the
13 alleged invention. The notion was, I have my digital
14 photographs or digital videos, whatever content I have,
15 I need a computer that can interface with devices to
16 receive that content and then has sufficient power to
17 transmit that content out using a mail application or
18 other transfer protocol.

19 This is clearly shown and described in
20 Figure 1. It's clearly described in the specification.

21 What Fotomedia is trying to do is to say
22 all we need for a computer is a device having a
23 processor for processing data, very generic description.
24 In 1996, 1997 that could cover a digital wristwatch. A
25 digital wristwatch has a processor, processes data and

1 it displays time. It clearly has nothing to do with the
2 invention, the alleged invention here.

3 As we described in our brief, there were
4 some other examples we gave of different types of
5 devices that were digital in 1996, 1997, an alarm clock
6 for example. Again, devices that were not able to
7 process data, not in the manner described in the patent,
8 certainly not to process digital image data.

9 So what the Plaintiff has done is
10 proposed a construction that wouldn't even meet the
11 basic requirements of the specification, which I submit
12 is consistent throughout. Establishing a base line of
13 technology in the background section, and then planning
14 for further advances in that technology through saying
15 the minimum requirements of performance in interface
16 must be met.

17 To address one final point. I --

18 THE COURT: Excuse me just a second. You
19 may want to slow down just a little bit.

20 MR. DUNHAM: Sure.

21 THE COURT: Okay. I just --

22 MR. DUNHAM: I'm sorry. I'm looking at
23 the two minute warning too here.

24 THE COURT: I understand.

25 MR. DUNHAM: To sort of sum up, there is

1 no disclosure that Fotomedia has been able to point to
2 in the specification, the prosecution history, no where,
3 that anything other than a personal computer is what is
4 contemplated or disclosed by the inventors. And in
5 terms of the argument that Fotomedia has accused the
6 Defendants of trying to limit the claims to the
7 preferred embodiment, the preferred embodiment is
8 actually a computer with specific processing
9 capabilities, i.e., the 32-byte processor and certain
10 other features of connectivity, and then also specific
11 examples, an Apple MacIntosh computer and a certain IBM
12 computer were both disclosed.

13 The Defendants are not attempting to
14 limit the scope of the claims to those particular
15 attributes or those particular embodiments, but we think
16 that the jury will understand a personal computer is
17 quite different from a cell phone, and particularly in
18 1996, 1997, and we think it's very important that the
19 background of the patent explains in order to allow the
20 applicants to even pursue their invention, they needed a
21 certain minimum threshold of computing technology, they
22 took the time to explain that to us, and it is not
23 proper for them to try to back away from that now.

24 Lastly, the Plaintiffs have suggested
25 that limiting the scope of claims to an invention that

1 may at some times be referred to as a preferred
2 embodiment is improper, and if the Court hasn't had a
3 chance to look at the decision in the dot.com case, this
4 is an example of several -- one of several cases cited
5 in our brief, where the Federal Circuit has indeed
6 looked at what was described at least at some points in
7 the specification as a preferred embodiment, and none
8 the less held that that is actually proper in terms of
9 the scope of the claims given the entirety of the
10 disclosure. And we submit that the decision reasoning
11 applies equally in this case.

12 If you have any questions on the other
13 terms, I'm happy to address them or I will pass the
14 torch.

15 THE COURT: Thank you.

16 MR. DUNHAM: Thank you.

17 MR. RAMSEY: Good morning, Your Honor,
18 I'm Gabe Ramsey, counsel for Photobucket, and I'm going
19 to be taking up the '231 patent, the last patent that's
20 at issue in this case.

21 You know, before I do so, I'm only going
22 to address three particular terms in the '231 patent,
23 that's all I have planned. I can take up questions on
24 other terms, but in the interest of time, I am going to
25 limit the discussion to roles, associating roles with

1 individual metadata elements, and metadata elements for
2 an image.

3 Before I dive into the particular terms
4 and phrases, however, I want to provide a little bit of
5 context about our approach and the background of the
6 patent.

7 First of all as with the other patents in
8 the case, the Defendants have approached claim
9 construction from the perspective of one of ordinary
10 skill in the art. We have in mind that one of ordinary
11 skill in the art would be a person with a bachelor's
12 degree in computer science, computer engineering or the
13 equivalent, and one to two years of experience building
14 or working with access control for file storage systems.
15 Very similar in some respects to the person of ordinary
16 skill in the art for the other two patents in this case.
17 But the '231 patent is a patent involving different
18 technology, a number of years later, four to five years
19 later and a different inventor than the original two
20 patents that we've addressed today. So, our person of
21 ordinary skill in the art reflects that.

22 Second, it's -- to deal with claim
23 construction of any of the terms of this patent it's
24 important to keep two basic fundamental aspects of the
25 '231 invention in focus.

1 The first of these is that the '231
2 patent involves access based on roles. This concept of
3 roles is critical to the invention. The concept of
4 role-based access is different from -- than prior art
5 systems that simply involved identifying a user and
6 allocating access rights or permissions to that user.
7 That simple interaction was already well known in the
8 prior art. We indicated in our brief the inventor's
9 discussion of that.

10 This concept of role-based system using
11 an intermediary designation to control access is
12 different -- what was different from the prior art, so
13 we've got to keep that in mind.

14 The second major essential feature of
15 this invention is that access control was contemplated
16 to provide very granular access on an individual
17 metadata element by metadata element basis. This is not
18 a system that involved access control to sets of images
19 or albums or all of the metadata that may be associated
20 with an image. That too was known in the prior art,
21 it's discussed in the prosecution history, and was
22 discussed by the inventor during the deposition.

23 The patent instead focuses on control to
24 individual metadata elements, and I will talk a little
25 bit more about that.

1 With those two basic ideas in mind, I
2 will turn to the construction of roles.

3 Defendants propose a construction of
4 roles as intermediary designations to bring together
5 users and access privileges. And I should point out
6 that the Defendants' construction is very slightly
7 changed from in the briefing. We have been continuing
8 to communicate with the Plaintiff and address a couple
9 of points in their reply brief. We have changed
10 permissions to --

11 THE COURT: Excuse me just a second.

12 MR. RAMSEY: Yes.

13 THE COURT: The same admonition. You
14 have to slow down.

15 MR. RAMSEY: Slow down, and I don't even
16 have my two minute warning yet.

17 THE COURT: Yes, you do.

18 (Laughter.)

19 THE COURT: So, please -- I'm serious.

20 MR. RAMSEY: Very good.

21 We have changed permissions to access
22 privileges to address Plaintiff's taking issue with that
23 point. We have removed the word collections from the
24 construction.

25 So, the Defendants' construction again

1 for the record is intermediary designations to bring
2 together users and access privileges.

3 This concept of roles is not coextensive
4 with the users of a system. Roles are not users. Roles
5 are also not coextensive with the access privileges that
6 a user might be assigned, that they are allowed under
7 the system, it is not coextensive with that concept
8 either. Rather roles are an intermediary designation, a
9 separate, independent and discreet construct that bring
10 together the users on the one hand, and the access
11 privileges that an individual user may be assigned on
12 the other.

13 And an analogy that we have used and
14 found helpful is a protective order in the litigation,
15 and I offer that as an analogy. In a protective order
16 system, which is a kind of system of access control,
17 there may be a role, outside counsel. I, as a user of
18 that system, to determine whether I have access to
19 certain information that is governed by that role, the
20 system doesn't care that I'm Gabe Ramsey. It doesn't
21 care who the individual user is. It merely asks the
22 question, what is the role? And if the answer is
23 outside counsel, then -- and the system understands that
24 role as being the requestor of access, then access to
25 the information is granted. Merely offered as sort of a

1 practical -- a practical nuts and bolts analogy to help
2 understand the concept of roles in this patent.

3 Defendants' construction of why should it
4 be adopted? First of all, it is precisely supported by
5 the structure and the plain language of the claims of
6 the '231 patent. And particularly I have highlighted
7 here elements B, C and E of Claim 1 of the '231 patent.
8 The structure is repeated through all of the claims.
9 The claims of the patent involve first, associating
10 users with roles; second requires associating roles with
11 individual metadata elements; finally in Element E
12 involves comparing the users' role to the roles
13 associated with the metadata elements.

14 In this structure, clearly the role is
15 acting as an intermediary between the user on the one
16 hand and the access privileges that are granted, and
17 what those may be on the other end of the system.
18 Defendants' construction simply reflects this
19 understanding in the plain language in the structure of
20 the claims.

21 Second, Defendants' construction is
22 supported directly by Fotomedia's own extrinsic evidence
23 in their brief. And this is how we came to our current
24 formulation attempting to narrow the dispute with the
25 Plaintiff. In particular the article regarding

1 role-based access control models that Your Honor
2 mentioned during Plaintiff's presentation, defines roles
3 as a -- a role is both a collection of users on one side
4 and a collection of permissions on the other. The role
5 serves as an intermediary to bring these two collections
6 together. This is directly consistent with the
7 Defendants' proposed construction. Plaintiffs cited it
8 in their own brief.

9 In the slide that is up right now, there
10 is also a graphical presentation of roles from that same
11 article cited at Exhibit G to Plaintiffs' brief. We can
12 see that roles is a discreet, distinct intermediary
13 construct, an intermediary designation that is different
14 from users and the permissions and mediates between the
15 two in order to determine access.

16 Now another important aspect about roles
17 is that they are defined before access privileges are
18 assigned. They are not the same as access privileges.
19 In particular the patent in the case that each role is
20 assigned certain access privileges. Inherently in that
21 structure a role is an independent construct that is
22 defined by whatever features may define it, and then the
23 next step is access privileges are assigned to that
24 role. Roles are different than access privileges.

25 Well, as a practical matter what kind of

1 things are we talking about here, roles? Well, roles
2 may be selling agent, appraiser, seller in the real
3 estate example in the patent. In the patent it also
4 refers to job titles as an example of a role, that is
5 also reflected in Plaintiff's brief.

6 Again, intermediary designations between
7 a user and an access right. Those are not privileges,
8 they are not users, they are these intermediary
9 designations.

10 The problem with Fotomedia's construction
11 is that it improperly collapses the concept of roles and
12 privileges. And just to sort of get to the nub of it,
13 the mischief here is that Fotomedia is attempting to say
14 in their construction, designations for access
15 privileges to which one or more users may be associated,
16 they are attempting to say that in the collection of
17 access privileges inherently defines a role. That is
18 conflating the concept of roles and access privileges.
19 As I have indicated, roles are defined before these
20 access privileges are assigned. The problem with this
21 construction is that it would -- if adopted, it would
22 encompass the prior art. It would encompass the system
23 that simply involved a user requesting to the system
24 being allocated certain access rights, some collection
25 of access rights.

1 Under this construction, that may be
2 considered to have a role when there is no intermediary
3 designation called a role. It reads the concept of
4 roles out of the claims, and for that reason it is
5 flawed and should be rejected, and Defendants' supported
6 construction should be adopted.

7 Now having taken up roles, I will move on
8 to the phrase associating the roles with individual
9 metadata elements. Defendants' construction is that for
10 each of a plurality of metadata elements, assigning a
11 list of roles to the metadata element.

12 Defendants' construction reflects first
13 that there is more than one metadata element than the --
14 under the plain language of the claims. The claim
15 refers to associating the roles with individual metadata
16 elements, plural. Defendants' construction captures
17 that, Plaintiffs' does not. In fact, Plaintiffs' does
18 not offer a construction.

19 Second, Defendants' construction reflects
20 that roles are assigned to each individual metadata
21 element. Again, this is consistent with the plain
22 language of the claim in which roles are associated with
23 individual metadata elements on an individual basis.
24 Accordingly, Defendants' use of each is consistent with
25 the claims.

1 Sort of backing up, again the point of
2 the invention here was to provide very granular
3 element-by-element access to metadata, and the patent
4 observes that in the prior art when a user accesses the
5 image, the user is typically shown all of the metadata
6 associated with that image. Similarly the inventor said
7 that at the time of the invention, metadata -- images
8 and metadata were treated as a single unit.

9 THE COURT: You need to slow down, okay?
10 You have used -- the Defendants have used
11 about an hour and ten minutes.

12 MR. RAMSEY: Oh good, okay.

13 THE COURT: Are you -- are these the last
14 terms I'm going to hear about?

15 MR. RAMSEY: We have got one more after
16 me.

17 THE COURT: Okay.

18 MR. RAMSEY: The inventor contrasted his
19 invention to this prior art by saying that in his
20 invention metadata was about an image, is treated
21 separately from the image with respect to access.

22 Finally, in the prosecution history, in
23 emphasizing the acts that roles are associated with
24 individual metadata elements, the applicant
25 distinguished over prior art that involved access to

1 sets of images or albums in all of the metadata
2 associated with those things. Again, it is very
3 important here that access is on an element-by-element
4 basis. Defendants' construction reflects that reality
5 in the claims.

6 So how does this association of roles
7 with individual metadata, how is it carried out? Well,
8 the patent repeatedly refers to assigning lists of roles
9 to individual metadata elements. Over and over again
10 that structure is described, and Defendants'
11 construction reflects that idea.

12 THE COURT: What is the difference
13 between the list data structure and the table data
14 structure?

15 MR. RAMSEY: In the Defendants' view they
16 are essentially the same. We see that a list or table
17 is both a listing of some sort that would include the
18 roles that were associated with an individual metadata
19 element.

20 THE COURT: Well, the patentee looked
21 like he viewed them differently.

22 MR. RAMSEY: Well, I think if it would
23 solve the question, including list or table in the
24 construction would be acceptable. Defendants simply see
25 them the same, and were providing a concise way for the

1 jury to understand the term. But it is this concept of
2 listing of some sort of the roles that are associated
3 with an individual metadata element as opposed to all of
4 the metadata.

5 So again, Defendants' construction is
6 consistent with all of the disclosure in the
7 specification consistent with the claims and should be
8 adopted.

9 Finally, having considered what roles
10 are, considering associating roles with individual
11 metadata elements begs the question of what is an
12 individual metadata element? For that I will turn to
13 one of the very first elements in the claims defining
14 metadata elements for an image because it answers that
15 question.

16 Defendants' proposed construction for
17 metadata elements for an image is a plurality of data
18 elements associated with and about an image other than
19 the image itself.

20 Now in Fotomedia's construction they used
21 the terms variable and data structure. Defendants would
22 be amenable to including those terms as examples of data
23 elements in the construction. So it would be, as an
24 alternative, a plurality of data elements, for example,
25 variables and data structures associated with and about

1 an image other than the image itself.

2 I should say right away that the
3 formulation associated with and about an image other
4 than the image itself is simply the parties now agreed
5 construction of what image metadata is at a general
6 level. And so Defendants have simply incorporated that
7 understanding what metadata is at a more abstract level
8 into the construction and so there should be no dispute
9 about that.

10 Again, we're willing to include variables
11 and data structures as an example of data elements. So
12 that should narrow the dispute a little bit more. So it
13 really comes down to what are metadata elements?

14 Defendants propose simply using a
15 plurality of data elements to fill out the meaning of
16 that claim. Very close to the plain language of the
17 claim. We think that it reflects what one of ordinary
18 skill in the art would have understood it to be, and
19 reflects that there are a plurality of metadata
20 elements.

21 Indeed, the claim itself refers to
22 defining metadata elements, plural, for an image.
23 Defendants' construction reflects that.

24 What do we mean when we say data
25 elements? Well, to fill it out a little bit, the

1 specification refers to metadata elements in the image
2 file that have been populated with data, so this is some
3 sort of storage data element -- this is some sort of
4 storage data element that is populated with the metadata
5 itself.

6 So again, we think that data elements
7 reflects that understanding.

8 What are some specific examples of what a
9 data element is? Well, the patent refers to data
10 elements 120 here, seller name, property address,
11 street. Seller name, that variable over data element,
12 is the metadata element. The name, Gabe Ramsey, that
13 may be populated is the metadata. That is the
14 distinction that we're attempting to capture in our
15 Defendants' proposed construction.

16 A couple of problems with Fotomedia's
17 construction here as a label or tag for image metadata
18 such as a variable or data structure.

19 First of all Fotomedia's construction
20 does not account for the plural metadata elements in the
21 plain language of the claims. Instead it is phrased in
22 the singular, it is inconsistent with the claims for
23 that reason.

24 Second it is contrary to the plain
25 language of the claims in that it refers to information

1 for image metadata where the plain language of the claim
2 refers to metadata for an image. In that way it is also
3 inconsistent with the plain language of the claims.

4 And finally, it uses these tags and
5 labels which quite frankly it's not -- it's not clear
6 exactly how they are using those in the construction.
7 It just adds confusion, it diverges from the plain
8 language of the claims in a way that the Defendants'
9 construction does not.

10 And finally while the words tags and
11 labels are used throughout the specification in a couple
12 of places, when they are described the metadata elements
13 are described as something different from the tags or
14 labels. For example, at Column 3, lines 30-31, there is
15 a reference to the metadata elements being stored in a
16 tag. A tag is a piece of an image file that may have
17 some interaction with the metadata element at some --
18 some time in the processing, but does not define the
19 metadata element itself.

20 So that is -- that takes the terms that I
21 am going to address. If Your Honor has any questions, I
22 can take them up or pass the podium here.

23 Thank you.

24 THE COURT: Thank you.

25 MR. SACKSTEDER: I'm pleased to still be

1 able to say good morning, Your Honor. I'm Michael
2 Sacksteder from Fenwick and West. I represent
3 Shutterfly and speaking on behalf of the Defendants.

4 THE COURT: He has left you 15 minutes.

5 MR. SACKSTEDER: Thank you very much,
6 Your Honor. That gives me 15 minutes to try to convince
7 the Court to invalidate three claims, that's five
8 minutes per claim. But that's made a little bit --

9 THE COURT: It's going to take you 15
10 minutes to do that?

11 MR. SACKSTEDER: I don't think it will,
12 actually, Your Honor.

13 That is five minutes per claim, but it is
14 made a little bit easier because Claims 10 and 11 are
15 dependent claims and they incorporate the same
16 means-plus-function limitations as we are going to be
17 addressing here in Claim 9.

18 Also for time purposes, although all five
19 means-plus-function limitations are addressed in the
20 papers, I'm going to focus on the means for defining
21 limitation and the means for receiving limitation.

22 And to set the stage a little bit, we're
23 talking here about two different paragraphs of Section
24 112 of 35 USC. Paragraph 2 talks about claims being
25 required to particularly point out and distinctly claim

1 the subject matter which the applicant regards as his
2 invention. And when you have a means-plus-function
3 limitation under paragraph 6, then the corresponding
4 structure that is disclosed in the specification is
5 effectively part of the claim. So when you're looking
6 at whether the claim is indefinite under paragraph 2,
7 you have to look not just at the claim language itself,
8 but also the corresponding structure and whether that is
9 definite.

10 As the Aristocrat Technologies case says,
11 in a computer implemented claim with a computer
12 implemented function, as these are, the algorithm
13 disclosed in the specification for performing the
14 function is the corresponding structure as it is used on
15 a general or specific purpose computer.

16 Aristocrat makes it very clear that
17 that's because general purpose computers can be used for
18 all kinds of different things and you can't just give
19 one of ordinary skill in the art the idea of what the
20 claim covers and what the limits of the claim are unless
21 you also disclose an algorithm for performing that.

22 This is something also that Judge Davis
23 last year recognized in the Alcatel case, and I have
24 copies of that which I will hand up. I would prefer not
25 to take the time to do it right now, if that's okay.

1 And Judge Davis said that the -- talked
2 about a specific case where the specification did not
3 disclose sufficient structure where it simply described
4 the outcome of the claimed function, and does not
5 disclose a computer program to execute a particular
6 algorithm. And like Mr. Kitchen, I have something about
7 the Court's Superspeed Vs. IBM case that I like very
8 much, and that's this Court's formulation of how to look
9 at this. And Your Honor drew the distinction between
10 merely the result of the algorithm being disclosed,
11 which is not sufficient to make a claim definite, versus
12 how the algorithm performs that function. I think that
13 is what we're going to be looking at here, and that is
14 the distinction.

15 Here on the two limitations that we're
16 talking about, the construction of the proposed -- or
17 the corresponding structure that we have from Fotomedia
18 is kind of a laundry list of different computer hardware
19 and software, a server, a database, an image file, a web
20 browser or software application, or combination of
21 portions thereof, or the structures described in Figures
22 2, 3 and 5 and the equivalents of the structures
23 thereof. That's the means for defining metadata
24 elements and the means for receiving similarly a server,
25 a software application or portions, and the structure

1 described in Figure 1.

2 And that is an awful lot to say that it
3 is providing definiteness to one of ordinary skill in
4 the art.

5 And what I would like to do is direct the
6 Court to one more legal point. Here there are two
7 problems with this. One, there is no disclosure of an
8 algorithm for performing those functions at all. And
9 two, the other problem is that even if there were
10 something that you could tease out as an algorithm, it
11 also has to be clearly linked to the performance of the
12 function. And I don't think we see either of those
13 here.

14 So going first to the means for defining,
15 and what I'd like to do is direct the Court to what
16 Fotomedia said disclosed the algorithm here. In this
17 one they identified two portions of the specification.
18 One talks -- and this is means for defining metadata
19 elements -- and one keeps talking about storing metadata
20 elements without describing how those metadata elements
21 are defined. I suppose one could say that -- or they
22 could argue that defining and storing are the same
23 thing, but then they are not clearly linked, you won't
24 find that in the specification where this is a
25 disclosure for the structure for the means for defining

1 metadata elements.

2 So then there is one other citation to
3 the specification, and here it is a long portion from
4 the initial section of the patent, and it talks about
5 how well there are standards organizations that have
6 different metadata items that they may want to use or a
7 user might want to put something in with the users
8 pictures. The trouble with this is -- well, there are a
9 number of troubles. One, it's just the result, you
10 know, it's not the method for performing an algorithm.
11 Two, it's not something that's performed by any of those
12 structures that were identified. This is talking about
13 things that are done by a standards organization and
14 things that are done by a user. It has nothing to do
15 with what a server does or what the software does. It
16 just talks about what either a group of humans or
17 individual humans have done.

18 So, those are the principal problems,
19 there are also identification of these figures. This is
20 just a data structure where data is stored. That is a
21 result. Figure 3 is actually a blow out of a component
22 of Figure 2, that is another structure that is another
23 result, it's not an algorithm for obtaining the result.
24 Figure 5 is once again -- it's described in the
25 specification as an example set of metadata and roles

1 assigned to the metadata for use in a real estate
2 application. Again, it's what you get coming out, it's
3 not how you get it.

4 The other limitation that I want to
5 address is the means for receiving a request for access
6 to the metadata by a particular user wherein the user's
7 role is determined from the request. On this one, the
8 structure is a little bit different. It is a server, a
9 software application or portions or combinations
10 thereof, or the structures described in Figure 1 and the
11 equivalents of the structures thereof. Again, not
12 particularly definite even in and of itself.

13 The reference to Figure 1 is interesting
14 because it is the -- pretty much the entire internet
15 including both ends of this system. It describes one
16 possible system environment for performing all of this.
17 Again, it doesn't show how any of this is done, how the
18 function of receiving is performed.

19 There are a couple of portions from the
20 specification again that describe what Fotomedia says
21 are the corresponding structures of the algorithms
22 performed by the corresponding structures to the means
23 for receiving. This one, all it says is there's a
24 gateway server for receiving the images. It doesn't say
25 anything about any algorithm performed by that server

1 for receiving the images. Basically, the same thing
2 here. These are all of the portions of the
3 specification that are identified by Fotomedia for
4 performing the function of receiving. So, there is no
5 disclosure of any algorithm for receiving a request for
6 access to metadata.

7 The other thing there isn't is any
8 disclosure of any structure or algorithm for determining
9 a user's role from the request. That is no where in
10 Fotomedia's briefing. That is a part of the plain
11 language of the limitation, there is simply nothing
12 disclosed.

13 So it is the Defendants' contention that
14 these deficiencies in the corresponding structures or
15 what are purported to be the corresponding structures,
16 render Claims 9 through 11 indefinite and thus invalid.

17 Thank you.

18 THE COURT: Thank you. And thank you for
19 the time back.

20 Mr. Baker always used up all of his time.
21 I am being facetious.

22 MR. SHUMAKER: Good morning again, Your
23 Honor.

24 THE COURT: Good morning.

25 MR. SHUMAKER: I am not going to bore the

1 Court with just regurgitating the arguments we have in
2 our brief. So I direct the Court to Plaintiff's opening
3 brief and reply brief for the arguments in support of
4 its constructions.

5 But what I want to discuss in the next
6 few minutes is just really a high level rebuttal to some
7 of the points that the Defendants brought up in their
8 presentation.

9 Mr. Martin, could you please bring up my
10 presentation, please?

11 The first issue I want to address is the
12 Wright prior art reference issue, and there were two
13 real main points. One, counsel for Defendants
14 recognized that the prosecution history related to the
15 amendment stemming from the discussion about the Wright
16 reference was ambiguous and not clear. I think that is
17 critical because in order to find a disclaimer in the
18 prosecution history, that disclaimer must be clear and
19 unambiguous. I submit that given the admission by
20 Defendants' counsel, the prosecution history related to
21 the Wright reference is not clear and not unambiguous
22 and therefore under the controlling law, the statements
23 made in the prosecution history cannot be a clear
24 disclaimer of claim scope.

25 Furthermore, the statements made in the

1 prosecution history related to the type of image that
2 was received rather than the step of the user sending
3 that image.

4 Next I want to address the argument about
5 a personal computer and can a personal computer -- or
6 I'm sorry, must a computer be limited to a personal
7 computer, and was there any disclosure in the
8 prosecution history related to the scope of a personal
9 computer.

10 Mr. Martin, could you please bring up
11 Slide No. 11, please.

12 Slide No. 11 is a discussion of the '005
13 patent which was at issue in the prosecution history.
14 Interestingly, what the Examiner brought up was a
15 reference which discloses a video camera connected to a
16 CPU, having an image memory, a modem, and a cellular
17 telephone transmitter.

18 What this figure shows is that in the
19 prosecution history it was recognized that a video
20 camera could be coupled to a computer through a CPU and
21 then further coupled to a cellular telephone
22 transmitter, and the resulting image can then be sent
23 out from the device that is found in the '005 patent.
24 So what I want to present to you today is that in the
25 prosecution history it is fairly clear that there were

1 computers not specifically limited to a personal
2 computer, but a computer that could capture an image and
3 also transmit that image through a cellular telephone
4 transmitter, pretty close to a cell phone with a camera.

5 The next issue I want to address is the
6 issue of a server. Is that one server? Is it one or
7 more servers? There are quite a few issues related to
8 that term today.

9 First of all I would like to mention at
10 the outset that what is really being construed is the
11 term a. Does a mean one or more? Or does a only mean
12 one? The term server has not been construed. So
13 although today we're talking about a server meaning a
14 single server, given the parties' constructions is
15 probably going to be a dispute in the future as to what
16 is the definition of a server.

17 Now servers back in the 1996 time frame,
18 although disclosed in the --

19 THE COURT: You're not suggesting
20 somebody would try to end run a claim construction with
21 an infringement or noninfringement argument, are you?

22 MR. SHUMAKER: I am just saying the term
23 server itself could be a term for disagreement. Why do
24 I say that? Because does a server relate to a single
25 box server or does it relate to a rack of servers? And

1 is a rack of servers a single server or is it not? I am
2 just suggesting that the term that we're actually
3 construing, a, does it mean one or more? Or does it
4 just mean one? It may not actually capture the dispute
5 that the parties have right here because I believe the
6 real dispute is what is the construction of server? And
7 now once you determine what the construction of server
8 is, is there one of those devices or is there one or
9 more of those devices?

10 And I would argue that back in the 1996
11 time frame that the distributive computing environment
12 was known, it wasn't an area of research, and I would
13 also submit that if you go back in 1996 to look at
14 servers that existed at that time, they weren't all
15 limited to a stand-alone PC box. But again, that is
16 going to be an issue, I believe, of expert testimony,
17 and according to the expert, what is the scope of a
18 server back in 1996. I just wanted to bring out the
19 issue that the term that we're disputing right now, does
20 a mean one or more, actually doesn't address, I think,
21 the corresponding issue which I believe the parties are
22 going to dispute eventually as to what is the
23 construction of a server.

24 Now getting back to actually the argument
25 of should a mean one or more or not? Clearly under the

1 law in order to limit a to only one, there must be a
2 clear intent evinced in the prosecution history. Now,
3 what is the argument for clear intent?

4 Let's look at the claim language. The
5 claim language says a server and there is also a
6 corresponding claim language that says at least one --

7 Mr. Martin, you can go on and pull off
8 this slide.

9 -- at least one CPU. And Your Honor
10 brought up the question, well, if the applicants knew
11 how to interpret a and also how to interpret at least
12 one, why did the applicant use a in one situation and at
13 least one in another situation and intend those two
14 phrases to mean exactly the same thing?

15 Well, I think one way to answer that
16 question is let's look at the term at least one CPU,
17 which is found in Claim 1 of the '936 patent. What does
18 that term connote? Well, it connotes at least one CPU
19 which implies there's two situations. One, you have a
20 multiprocessor computer which has more than one CPU in
21 the box. Or you could have a distributed computer
22 system where you have more than one server or more than
23 one server computer and because you have more than one
24 server, you have more than one CPU. So the claim
25 language at least one CPU, I believe, refers to -- or

1 connotes the concept of a single computer having a
2 multiprocessor architecture or a distributed computer
3 environment. I think that is precisely why the
4 applicants used the term at least one CPU in the claim
5 language and also used the term a server in the claim
6 language.

7 THE COURT: And were servers with the
8 dual processors, those were used in '96?

9 MR. SHUMAKER: I believe so because when
10 I was in grad school back in 1991, I used a
11 multiprocessor computer, so yes, I would certainly
12 suggest in 1996 --

13 THE COURT: I don't know, my time line is
14 a little fuzzy.

15 MR. SHUMAKER: I would represent that in
16 1996 that I believe those computers existed, but again,
17 that is going to be an area for experts, not obviously
18 for attorney argument.

19 Which brings me to another interesting
20 issue. The Defendants in a large number of their
21 constructions pointed to the testimony of inventors,
22 Neal Mayle. Now under Federal Circuit law it is clear
23 that inventor testimony is absolutely irrelevant to
24 claim construction, and the Court cannot put any weight
25 to any inventor testimony for claim construction.

1 Mr. Martin, could you please pull up --
2 let me -- I have it here some place.

3 MR. MANLEY: Do you want the Howmedica
4 case?

5 MR. SHUMAKER: Yes, the Howmedica case.

6 MR. MANLEY: There it is.

7 MR. SHUMAKER: Oh, it is right there.
8 Okay.

9 So under the Howmedica case it is clear
10 that inventor testimony as to the subjective intent is
11 irrelevant. So what the inventor testifies regarding
12 the scope of the invention, doesn't have an influence on
13 the actual scope of the claims that we're talking about
14 today. What the Howmedica case also said is, well, if
15 the inventor is also an expert, then his testimony can
16 be related to expert testimony. There is no suggestion
17 today that the inventor was an expert or was presented
18 as expert testimony. His deposition was solely for
19 inventor testimony. And because it was an inventor
20 deposition, his testimony is not relevant for claim
21 construction purposes today.

22 Another issue with respect to the
23 construction of a server. Part of the claim language
24 we're pointing to when we talk -- when we point to at
25 least one CPU refers to Claim 1 of the '936 patent which

1 was issued after the '774 patent. And the parties have
2 agreed to construe a server to be consistent across the
3 '774 patent and the '936 patent, and therefore it's not
4 appropriate to somehow link language introduced after a
5 claim was issued to thereafter narrow that issued claim
6 language.

7 Next I am going to talk about image
8 metadata and I believe when Your Honor asked me a
9 question about the definition of metadata, I was
10 referring to the definition -- we're looking to the
11 definition of metadata in the prosecution history.
12 Well, the parties have actually agreed upon the
13 definition of image metadata in this case. And the
14 parties agreed that image metadata should mean
15 information associated with and about the image other
16 than the image itself.

17 In the Defendants' arguments regarding
18 the, quote, scope of the invention, there was quite a
19 few references made to electronic postcard, and the
20 Defendants pointed to the fact that this invention was
21 related to electronic postcard. I would like to point
22 Your Honor back to the summary of the invention and I'll
23 submit to you that the summary of the invention does not
24 limit the invention to electronic postcard. It's a much
25 more broadly claimed invention than electronic postcard.

1 Now I want to address roles. I believe
2 the parties' constructions are actually fairly similar.
3 The only dispute Fotomedia has is does the term
4 intermediary designations make any sense? We submit
5 that it doesn't. Either roles should be an intermediary
6 or a designation, but the combination of those two terms
7 renders the Defendants' construction ambiguous and
8 vague.

9 One last issue I want to address and
10 that's the issue of the uniqueness concept in the URL,
11 what does it mean to be unique? The Plaintiff's
12 position is that the URL itself must not be linked
13 inexorably to a single image, and Fotomedia believes
14 that Defendants' construction could cause a jury to
15 believe that a unique URL must be tied to a single
16 image, not to multiple images.

17 And one last term. The term a display
18 that under the Defendants' construction a display is
19 construed in the context of a fixed display -- or a
20 fixed image, excuse me. And I think that is not correct
21 according to the intrinsic evidence. Because what the
22 intrinsic evidence states is that the display can
23 include fixed images, but a display is not itself
24 limited to a fixed image. Moreover in the
25 specification, a discussion of a fixed image relates to

1 the efficiency of the invention rather than the actual
2 steps performed by the invention. The reason the
3 applicants disclosed a fixed image was to enhance the
4 download speed of the electronic postcard because if an
5 image didn't change, there was no reason to download
6 that image for the second time. If the image changed
7 and it was no longer fixed, then the image itself was
8 downloaded. But the concept of fixed really was related
9 to efficiency purposes of the invention and not the
10 actual steps that were claimed by the invention. And
11 furthermore a GIF image can be animated, and an animated
12 GIF image, is that a fixed image or is that not a fixed
13 image? I don't know the answer to that question, and I
14 suspect that we're going to get varying answers to that
15 question because the image itself can move, it can be
16 animated. So in some sense that is not fixed, but if
17 you look at the underlying data, does that change or
18 not? And I think there is two different levels of
19 abstraction that will be at issue when we discuss a
20 fixed image that could be an animated GIF image, which
21 is another reason why Defendants' construction for
22 display is incorrect.

23 And with that, I thank Your Honor for
24 your attention and the Plaintiffs are done.

25 THE COURT: Thank you.

1 Thank you for the arguments and the very
2 good briefing on the points. I will get you an order as
3 soon as I can. The claim construction issue is under
4 submission.

5 COURT SECURITY OFFICER: All rise.

6 (Court adjourned.)

7 * * * *

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9
10 C E R T I F I C A T I O N

11
12 I HEREBY CERTIFY that the foregoing is a
13 correct transcript from the stenographic notes of the
14 proceedings in the above-entitled matter to the best of
15 my ability.

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18
19
20 _____
21 SUSAN SIMMONS, CSR
22 Official Court Reporter
State of Texas No.: 267
Expiration Date: 12/31/08

Date